

Neifeld Docket No: DEATON-18-USC1

Application/Patent No: 08/935,116

USPTO CONFIRMATION NO: 8230

File/Issue Date: 9/22/1997

Inventor/Title: DEATON/System, Method and Database for Processing Transactions

Examiner/ArtUnit: ALVAREZ, Raquel/3622

ENTITY STATUS: LARGE

PRIORITY CLAIM - FIRST SENTENCE OF SPECIFICATION: This application is a continuation of pending U.S. Application Serial No. 08/117,951 filed August 30, 1993 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," pending; which is a continuation of U.S. Application Serial No. 07/826,255 filed January 24, 1992 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," abandoned; which is a continuation of U.S. Application Serial No. 07/345,475 filed May 1, 1989 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," abandoned."

37 CFR 41.37 APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22213-1450

Sir:

In response to the non final office action mailed 11/26/2008, and further to the amendment filed 1/16/2009 canceling claim 16, the applicant renews the appeal.

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I. **37 CFR 41.37 (A)(1) AND (2)**

The Brief and Notice are submitted herewith.

The applicant previously appealed, without decision. On 5/16/2006, the applicant paid the fees for Notice of appeal and appeal brief totaling \$1000. The current fees for a Notice and Brief are \$1080. The applicant pays the \$80 difference herewith by the attached authorization to charge deposit account.

II. **37 CFR 41.37 (B)**

The Brief, Notice, and fee are timely submitted.

III. **37 CFR 41.37 (C)(1)**

A. **37 CFR 41.37 (c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing Corporation, a Delaware corporation.

B. **37 CFR 41.37 (c)(1)(ii) Related Appeals and Interferences**

This application was involved in an interference with O'Brien, interference 104,607. Deaton was elected by the joint assignee. A copy of the judgement is attachment 1 in the appendix.

This application was the subject of a prior appeal, appeal docket no: 2004-0786. A copy of the DECISION ON APPEAL in appeal docket no: 2004-0786 is attachment 2 in the appendix.

C. **37 CFR 41.37 (c)(1)(iii) Status of Claims**

Claims 17-76 were reinstated as a result of grant of a petition after the filing of the prior appeal brief.

Claims 1-7 and 16 are canceled.

Claims 8-15 and 17-76 are rejected.

Claims 8-15 and 17-76 are pending.

The rejections of claims 8-15 and 17-76 are appealed.

D. **37 CFR 41.37 (c)(1)(iv) Status of Amendments Filed Subsequent to Final Rejection**

There is no final rejection, and therefore there is no amendment filed subsequent to final

rejection.

An amendment filed just prior to this appeal cancels claim 16.

E. **37 CFR 41.37 (c)(1)(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, -- and each means plus function argued separately**

The pending independent claims are: 8, 9, 10, 11, 15, 17, 22, 27, 30, 33, 34, 66.

Only claim 8 contains a means plus function recitation.

Claim 8 defines a system for accumulating customer transaction data at the point-of-sale in a retail establishment and for effectuating customer promotion on the basis thereof, comprising (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

a terminal for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction (page 21 lines 7-22, figure 1: 120; Fig 2A: 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

means for allowing entry of customer transaction data (page 21 lines 7-22, figure 1: 120; Fig 2A: 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

a processor (page 18 line 13, figure 1: 112) and a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (page 34 line 28 through page 37 line 8); and

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer (page 16 lines 9-18; Fig. 2A: 120), said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit (page 16 lines 19-23), and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion (page 1 lines 3-10).

Claim 9 defines a system for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

apparatus for entering unique customer identification codes from customer identification presented at the point-of-sale in said retail establishment;

a terminal for entering customer transaction data at the point-of-sale in said retail establishment (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

a processor (page 18 line 13, figure 1: 112) and a memory responsive to said apparatus and said terminal for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (page 34 line 28 through page 37 line 8); and

circuitry associated with said memory and responsive to the entry of said individual customer's identification code during a transaction at the point-of-sale, said circuitry being operable to generate a customer information response signal at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit (page 16 lines 9-23), said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion (page 1 lines 3-10).

Claim 10 defines a method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

entering customer transaction data (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (page 34 line 28 through page 37 line 8); and

generating a customer information response at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer (page 16 lines 9-18), said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit (page 16 lines 19-23), and said response providing information at said point-of-sale derived from said

database and useful for effectuating targeted customer promotion (page 1 lines 3-10).

Claim 11 defines a method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

entering unique customer identification codes from customer identification presented at the point-of-sale in a retail establishment;

entering customer transaction data at the point-of-sale in said retail establishment (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (page 34 line 28 through page 37 line 8);

accessing said database in response to the entry of said individual customer's identification code during a transaction at the point-of-sale (page 16 lines 9-18);

determining from said database the transaction history of said individual customer; and generating a customer information response at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit (page 16 lines 19-23), said response providing information at said point-of-sale derived from said database and useful for effectuating targeted customer promotion (page 1 lines 3-10).

Claim 15 defines a method for providing customer services in a retail establishment, comprising the steps of (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

entering into a point-of-sale terminal a unique identification code for a customer; entering into said terminal transaction data relating to the customer's shopping transactions (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

generating and maintaining a database, including the step of correlating said transaction data with said unique identification code (page 34 line 28 through page 37 line 8);

responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by

supplying said response to said terminal during said current transaction in which said unique identification code is entered (page 16 lines 9-18), said response including information for effecting a targeted promotion to the customer (page 1 lines 3-10).

Claim 17 defines "A computer implemented system for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120),:

a terminal for entering, during a transaction, a unique customer identification (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer code (page 34 line 28 through page 37 line 8);

circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal (page 1 lines 3-10); and

wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification (page 1 lines 3-10)."

Claim 22 defines "A computer implemented method for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising the steps of (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120),:

entering in a terminal, during a transaction, a unique customer identification (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

storing, in a database, transaction data from prior shopping transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with said an identification of that customer (page 34 line 28 through page 37 line 8);

transmitting to a point-of-sale during said transaction a customer information response signal in response to the entry of said unique customer identification at said terminal during said transaction (page 1 lines 3-10); and

wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification (page 1 lines 3-10)."

Claim 27 defines "A computer implemented system for updating data in a customer database, comprising (page 18 line 4 through page 19 line 12, figure 1: 110, 112, 114, 116, 117, 118, and 120):

a terminal for entering, during a transaction, a unique customer identification and transaction data for said transaction (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

a database storing transaction data for a plurality of customers from prior shopping transactions, such that transaction data regarding prior transactions of a customer are stored in association with identification of that customer (page 34 line 28 through page 37 line 8); and

circuitry responsive to the entry of said unique customer identification and said transaction data at said terminal for updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database, and for storing in said customer database the date that transaction data association with said unique customer identification was updated (page 1 lines 3-10)."

Claim 30 defines "A computer implemented method for updating data in a customer database, comprising the steps of (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138):

entering in a terminal, during a transaction, a unique customer identification and transaction data for said transaction (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138);

storing, transaction data for a plurality of customers from prior shopping transactions, such that data regarding a prior transactions of a customer are stored in association with identification of that customer (page 34 line 28 through page 37 line 8); and

updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database in response to entry of said unique customer identification and said transaction data at said terminal (page 1 lines 3-10); and

storing in said customer database the date that transaction data association with said unique customer identification was updated (page 35, lines 21-26)."

Claim 33 defines "A computer implemented customer database comprising stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer said transaction data stored in association with an identification of that customer including (page 21 lines 7-22, figure 2A: 120, 122, and 124, figure 2B: 124, 130, 132, 134, 136, and 138; and (page 34 line 28 through page 37 line 8)):

dollar amount of purchases and time period (page 35 lines 19-24; page 36 lines 1-4; 14-16)."

Claim 34 defines "A computer implemented customer database comprising stored transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data stored in association with said identification of that customer including (page 34 line 28 through page 37 line 8):

total dollar amount of purchases purchased during a period of time (page 36 lines 19-20)."

Claim 66 defines "A computer implemented system comprising (page 1 lines 3-10):

computer implemented customer database comprising stored transaction data from prior point-of-sale transactions, said stored transaction data comprising (page 34 line 28 through page 37 line 8):

(1) data for a first customer such that data regarding said first customer's prior transactions are stored in a first customer record associating a first customer identification of said first customer with at least a first customer first dollar amount (page 34 line 28 through page 37 line 8); and

(2) data for a second customer such that data regarding said second customer's prior transactions are stored in a second customer record associating a second customer identification of said second customer with at least a second customer first dollar amount (page 34 line 28 through page 37 line 8);

a point of sale terminal (transaction terminals 120, Fig. 1, page 18 lines 18-24);
a digital data processor (transaction processor 112, Fig. 1, page 18 lines 18-24);

and wherein said system is programmed to respond to transaction information received from the point of sale terminal including said first customer identification by identifying said first customer record in said database, and returning to said point of sale terminal a first customer information response signal (page 9 lines 23-25, page 19 lines 1-5);

wherein a value of said first customer information response signal depends at least in part upon data stored in said first customer record, including at least said first customer first dollar amount (page 1 lines 3-10, page 16 lines 9-27)."

F. 37 CFR 41.37 (c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal

Whether the rejections of claims 8-15 under 35 USC 102(c) as being anticipated by Nichtberger et al. (4,882,675 hereinafter "Nichtberger") are improper and should be reversed.

Whether the rejections of claims 17-76 under 35 USC 103 as obvious based upon Nichtberger and official notice should be reversed.

The appellant notes that these are the grounds of rejection stated by the examiner, not the appellant. In accordance with 37 CFR 41.37(c)(1)(vii), the appellant argues separately for reversal of the rejection of appealed claims subject to the same ground specified by the examiner. However, 37 CFR 41.37(c)(1)(vii) states in pertinent part that: "For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group." The appellant presents arguments for many different groups below.

G. 37 CFR 41.37 (c)(1)(vii) Argument

Arguments respecting each ground of rejection are presented in a separate section for each ground specified in the prior subsection, as required by rule. 37 CFR 41.37(c)(1)(vii) states that "Each ground of rejection must be treated under a separate heading."

IV. WHETHER THE REJECTIONS OF CLAIMS 8-16 UNDER 35 USC 102(E) AS BEING ANTICIPATED BY NICHTBERGER ET AL. (4,882,675 HEREINAFTER

“NIGHTBERGER”) ARE IMPROPER AND SHOULD BE REVERSED

a. THE EXAMINER'S POSITION

In support of the rejections of claims 8-16 under 35 UC 102(b) as being anticipated by Nichtberger, the examiner stated in both of the two most recent office actions that:

With respect to claims 8-15, Nichtberger teaches a system for accumulating customer transaction data at the point of sale in a retail establishment and for effectuating customer promotion (abstract). A terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction (col. 17, lines 30-48); means for allowing entry of customer transaction data (col. 17, lines 49-60); a processor and a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (col. 12, lines 16-32); circuitry responsive to said processor, memory, and a database for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer (col. 11, lines 46-50 and col. 18, lines 49-61); said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit (col. 17, lines 49-61); and said signal providing information at said point of sale terminal derived from said database and useful for effectuating targeted customer promotion (col. 17, lines 49-61).

Claim 16 differs from claims 8-15 in that it further recites that the entering step into a point-of-sale terminal is an account number from a payment instrument presented by a customer. Nichtberger teaches that a credit card with a magnetic stripe can be used to activate the system (col. 19, lines 63 to col. 20, lines 1-7). [Office action dated February 17, 2006 page 2 line 16 through page 3 line 11; and

office action dated 11/26/2008, page 2 line 13 to page 3 line 11.]

In support of the rejections of claims 8-16 under 35 UC 102(b) as being anticipated by Nichtberger, the examiner stated in the examiner's answer dated 12/12/2006, which responded to appellants former appeal brief arguments, which was an appeal in response to the office action dated February 17, 2006, clarification of the basis for rejection. The examiner's answer dated 12/12/2006 stated in pertinent part that:

(10) Response to Argument

Appellant argues that Nichtberger's CDR 20 is not a point of sale terminal and is not at a point of sale location. The Examiner wants to point out that the *Examiner never cited CDR 20 for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment.* The Examiner wants to point out to col. 17, lines 29-47, which teaches "At the checkout counter, the customer presents his special card ... before the checkout process begins ... the special card also bears the customer number in UPC bar code format, it can be read automatically by the store's scanning system The UPC codes of items customer purchased are scanned or entered" *As can seen by above, Nichtberger clearly teaches that the customer information is entered and from the information entered by the customer's card at the point of sale (checkout) during the customer's transaction at a retail establishment,* the corresponding list of coupons are presented or displayed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the customer need take no action he or she otherwise would not take) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that Nichtberger's system doesn't teach automatically

responding to a customer purchases of goods in a store. The Examiner disagrees with Appellant because Nichtberger teaches that the coupons displayed are based on previous transactions (col. 18, lines 20-41).

Appellant argues that Nichtberger doesn't teach a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit. The Examiner disagrees with Appellant because Nichtberger teaches that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons. The redemption and buying habits are recorded in database 420 and is used by processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41). [Examiner's answer dated 12/12/2006, pages 3-5; emphasis supplied.]

Thus, the examiner admitted that Nichtberger's CDR 20 is not a point of sale terminal and is not at a point of sale location.

Moreover, in that examiner answer, the examiner alleges "*that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons. The redemption and buying habits are recorded in database 420 and is used by processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41),*" - - teaches the claimed "circuitry"; claimed "customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer"; claimed "signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit"; and claimed "signal providing information at said point-of-sale terminal derived from said database."

As noted below, the appellant disagrees with those assertions.

b. **CLAIM 8 - THE ANTICIPATION REJECTION OF CLAIM
8 SHOULD BE REVERSED (APPLIES TO CLAIMS 8-15)**

Claim 8 recites:

8. (Previously presented) A system for accumulating customer transaction data at the point-of-sale in a retail establishment and for effectuating customer promotion on the basis thereof, comprising:

a terminal for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

means for allowing entry of customer transaction data;

a processor and

a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer,

said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and

said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

c. **CLAIM 8 - IDENTIFICATION OF THE EXAMINER'S
ERRORS (APPLIES TO CLAIMS 8-15)**

The examiner errs in concluding that Nichtberger discloses the claimed customer information response signal and its related limitations, and errs in the examiner's underlying

factual conclusions. Here is what claim 8 defines, that Nichtberger fails to disclose:

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer,

said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and

said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

d. **CLAIM 8 - THE EXAMINER HAS NOT MADE A PRIMA FACIE CASE - "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale" (APPLIES TO CLAIMS 8-15)**

Claim 8 specifies "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale", and the signal provided by that circuitry is "related to said individual customer's transaction data in shopping visits prior to the current shopping visit," and "derived from said database." Nichtberger provides no such circuitry, and Nichtberger provides no such signal at the point of sale. The examiner's specific reasoning regarding Nichtberger on this point is flawed. The examiner's reasoning is that:

Appellant argues that Nichtberger doesn't teach a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit. The Examiner disagrees with Appellant because *Nichtberger teaches that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons. The redemption and buying habits are recorded in database 420 and is used by*

processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41). [Examiner's answer dated 12/12/2006, page 5; emphasis supplied.]

There is no prima facie case because the examiner's assertions do not support the examiner's conclusions that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

The examiner's first assertion is that "*Nichtberger teaches that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons.*" That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

The examiner's second assertion is that "*The redemption and buying habits are recorded in database 420 and is used by processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41).*" That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

The examiner's only other 'assertion' is what is stated in the office action, which is a mimic of the claim language with cites, without explanation. Specifically, with respect to the circuitry limitation a cite to Nichtberger col. 17 lines 49-61. Nichtberger col. 17 lines 49-61 discloses Nichtberger's system determining for which of the customer's product items the customer has pre selected coupons, and applying credits for those coupons to the customer's order. That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit." In fact, Nichtberger discloses that the consumer selects coupons during the same visit that the customer uses the coupons, and that Nichtberger's customer's coupon selections are not transactions. Accordingly, the examiner has made no prima facie case.

e. **CLAIM 8 - NICHTBERGER IN FACT FAILS TO DISCLOSE - "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale" (APPLIES TO CLAIMS 8-15)**

The panel should at this point construe the circuitry limitation "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale." Normal claim construction follows from the plain of words, as defined in the specification, meaning of the words in the claim, grammar, and corresponding disclosure in the specification. The following sections construe "point of sale;" "customer information response signal;" "database;" and "circuitry" in claim 8.

f. **CLAIM 8 - MEANING OF "at the point-of-sale" (APPLIES TO CLAIMS 8-15) - NICHTBERGER'S CDR UNIT 20 IS NOT AT A POINT OF SALE**

The plain meaning of "at the point of sale" is at the location where sale occurs. However, the specification discloses that at the point of sale is the location of the point of sale terminal at which the transaction data for the sale is entered into the point of sale system. As noted in our specification:

Many such systems require connecting a *point-of-sale terminal* through telephone lines to a remote transaction processing system, thereby increasing not only the cost of operating the systems, but also increasing the time for providing check verification. Also, existing systems typically do not focus on maintaining a local customer database useful not only for check transaction processing, but also for identifying new customers and developing customer profiles for regular customers. [Page 7]

The system includes one or more transaction terminals, coupled to a

transaction processor that stores the customer database. *A transaction terminal is used to transmit a customer information request (such as for check transaction verification), which includes a customer's check identification number, from the point-of-sale (POS) to the transaction processor.* [Pages 8 and 9; emphasis supplied.]

Just as importantly, a point of sale is not a location where another terminal resides. Specifically with respect to Nichtberger, CDR unit 20, which Nichtberger discloses to be the kiosk at which coupons are displayed to and selected by customers, is not at a point of sale. First, the examiner admits that the CDR unit 20 is not a point of sale terminal and is not at a point of sale, and that instead Nichtberger's checkout counter, is at the point of sale, stating that:

Appellant argues that Nichtberger's CDR 20 is not a point of sale terminal and is not at a point of sale location. The Examiner wants to point out that the *Examiner never cited CDR 20 for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment.* The Examiner wants to point out to col. 17, lines 29-47, which teaches "At the checkout counter, the customer presents his special card ... before the checkout process begins ... the special card also bears the customer number in UPC bar code format, it can be read automatically by the store's scanning system The UPC codes of items customer purchased are scanned or entered" *As can be seen by above, Nichtberger clearly teaches that the customer information is entered and from the information entered by the customer's card at the point of sale (checkout) during the customer's transaction at a retail establishment,* the corresponding list of coupons are presented or displayed. [Examiner's answer dated 12/12/2006, page 3; emphasis supplied.]

That is an express admission by the examiner that Nichtberger's CDR 20 is not at a point of sale.

Moreover, the panel in the prior appeal on this application came to exactly the same conclusion regarding the "at the point of sale" recited in claim 8 respecting improper rejections over a Creekmore reference. *There, that panel found that the location of data entry at a terminal other than the checkout/point of sale terminal, was not at a point of sale location.* Here is the relevant passage from that decision.

From our review of Creekmore's disclosure, we find that Creekmore discloses (col. 5, lines 18-28) that *"the input terminal 13 . . . may be positioned at any convenient point-of-use location such as a location near the checkout lanes of a grocery store.* When a customer desires to undertake a particular checking function, such as paying presently-unknown amount for the purchase of groceries, he inserts his identification card 25 into a slot 26 provided on the side 27 of the input terminal. The customer next places a blank check 28 face-down on the check tray 29, and then slides the check tray into the opening provided in the front face 30 of the input terminal." Creekmore further discloses (col. 5, lines 57 and 58) that in this example, it is presumed that a customer has not passed through the checkout lane of the store.

From the disclosure of Creekmore, *we agree with appellants that a customer of Creekmore will first go to the check verification terminal for check approval, and then go to the checkout. Thus, Creekmore does not disclose that the terminal for entering the unique customer codes is located at the point-of-sale,* as required by claim 8. [Decision in Appeal 2004-0786 in this file history, pages 8 and 9, Attachment 2 in the appendix; emphasis supplied.]

Just as with Creekmore's input terminal 13, Nichtberger CDR unit 20 is not at a point of sale within the meaning of claim 8. As a result, the claimed "circuitry .. for generating a customer information response signal at the point-of-sale" means circuitry at the point of sale terminal, not circuitry at some other terminal. The foregoing review excludes the location of Nichtberger's CDR unit 20 from being "at the point of sale". Therefore, nothing at Nichtberger's

CDR unit 20 could correspond to the claimed "circuitry .. for generating a customer information response signal at the point-of-sale".

g. **CLAIM 8 - MEANING OF "a customer information response signal" (APPLIES TO CLAIMS 8-15) - A SIGNAL RETURNED TO THE POS TRANSACTION TERMINAL THAT IS A RESPONSE TO A SIGNAL SENT FROM THE POS TRANSACTION TERMINAL IDENTIFYING THE CUSTOMER, AND THAT DEPENDS UPON TRANSACTION DATA IN THE DATABASE FOR THE CUSTOMER'S SHOPPING VISITS PRIOR TO THE CURRENT SHOPPING VISIT**

The plain meaning of the words "customer information response signal" is a signal that is a response that relates to customer information. The Summary of the Invention section contains antecedent for "customer information response," stating in pertinent part:

Thus, the method of this invention... involves: (a) identifying a customer by the customer's unique check ID; (b) developing and maintaining for a store a local customer database of customer records, each identified by the corresponding customer check identification number, and each including customer information (such as verification status and transactional data); (c) generating a customer information request; (d) processing the request using the customer check identification number to access the corresponding customer record, if any; (e) returning an appropriate *customer information response* based on the customer information in the customer record; and (f) updating the customer database regularly to reflect new customer information. [Page 9; emphasis supplied.]

This passage indicates that the *customer information response* is based upon customer information in the corresponding customer record in the customer database. Further, the

specification explains the process of sending the customer information request from the transaction terminal to the processor and receiving the response signal at the transaction terminal, stating that:

The system includes one or more transaction terminals, coupled to a transaction processor that stores the customer database. A transaction terminal is used to transmit a customer information request ..., from the point-of-sale (POS) to the transaction processor.

The transaction processor processes the customer information request ... to search the customer database and retrieve the corresponding customer record, if any. Based on the customer information in the customer record, or the lack of a customer record, *the transaction processor returns an appropriate response ... to the transaction terminal.* [Pages 8 and 9; emphasis supplied.]

Moreover, claim 8's additional limitations "said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion." require that claimed customer information response signal to be "related to said individual customer's transaction data in shopping visits prior to the current shopping visit." Thus, the customer information response signal is a signal returned to the POS transaction terminal that is a response to a signal sent from the POS transaction terminal identifying the customer, and that depends upon transaction data in the database for the customer's shopping visits prior to the current shopping visit.

h. **CLAIM 8 - MEANING OF "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale" (APPLIES TO CLAIMS 8., 9, 12, 13)**

The specification's example of "**circuitry responsive ... for generating a customer**

information response signal at the point-of-sale" is the circuitry driving display 124 that generates LED signals at the point of sale. This is the circuitry at the point of sale conveying the signal conveying the customer information response to a human at the point of sale. The detailed description of the transaction terminal, section 1.3 in the specification, indicates that the signal displayed by display 124 is the customer information response signal generated at the point of sale. The circuitry driving display 124 of the transaction terminal is what results in the generation of a customer information response signal at the point of sale. That is, the claimed "circuitry" that generates the customer information response signal at the point of sale is the circuitry relating to display 124. Section 1.3 in the specification states that:

1.3. Transaction Terminal.

As shown in FIGURE2A, each transaction terminal 120 includes a keypad 122 and a display 124. Keypad 122 is a 4x4 key matrix that includes specific keys for Function, Enter, Scroll, Clear and Back Space, as well as 0-9 and \$. Display 124 is a liquid crystal display capable of displaying two lines of up to twenty characters each.

For example, to initiate a check verification request, keypad 122 is used to enter the customer's check ID and the amount of the check, along with the function code designating check verification. This request is displayed on display 124, and sent to transaction processor 112. *The check verification response, including the customer's verification status (such as POSITIVE, NEGATIVE OR CAUTION), returned by the transaction processor is then displayed on display 124.* [page 21; emphasis supplied.]

In summary, the words of claim 8 and the specification indicate that claim 8's "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale" and related limitations mean in pertinent part circuitry at the point of sale designed to convey to a human a signal that is based upon the customer's transaction record for transactions prior to the current transaction.

i. **NICHTBERGER (APPLIES TO CLAIMS 8-15)**

Nichtberger is directed to distributing and, in the same shopping visit, redeeming, electronic coupons. Nichtberger's abstract is a reasonable summary. It states in relevant part (with emphasis supplied) that "An electronic display of coupons valid for use in a particular store is presented to customers in that store. When a customer makes a selection of coupons from the display, the selection is recorded. The customer is *subsequently identified at a store checkout station* as the one who made the selection. In a preferred embodiment, the identification is made by scanning a special card adapted for use with the system. The items purchased in the store by the customer are recorded, and any matches between the coupons selected and the items purchased are determined electronically. The customer is immediately credited in accordance with the terms of the matched coupons."

The "customer is *subsequently identified at a store checkout station*" indicates that the CDR and the checkout (the point-of-sale) are distinct structure in addition to having distinct functions. This point is amplified by the statement in the DETAILED DESCRIPTION of Fig. 1 that "After the user has made his or her purchases, he or she goes to one of the checkout stations and presents his or her card to the attendant at the station. The attendant causes the card to be read by a suitable card reader (such as a UPC card scanner) and the checkout system 18 then automatically credits the customer for the coupons the customer has selected where there are corresponding purchases against which the coupons are to be applied.." In other words, there is no proximal relation of the CDR to the point-of-sale. Nichtberger's physical description of an exemplary CDR also confirms that fact. Nichtberger states that "The functional objectives of the CDR unit 20 can be achieved through various hardware and software configurations. As one example, the CDR unit 20 may comprise a five foot high metal enclosure, on the front panel of which are mounted a color video monitor 88 (FIG. 5) with a touch screen sensor 90, a magnetic stripe card reader 92 and a coupon selection list printer 94, all within easy reach of a standing adult." Nichtberger Section F, col. 11 line 64 to col. 12 line 3. The point made here is that action at the CDR is not, and cannot be construed as, the claimed action "at the point of sale." In fact, the examiner admits in the prior answer that the basis of his rejection does not allege Nichtberger disclosed CDR is at the point-of-sale. ("Appellant argues that Nichtberger's CDR 20 is not a

point of sale terminal and is not at a point of sale location. The Examiner wants to point out that the Examiner never cited CDR 20 for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment.")

Nichtberger discloses that the CDR unit 20 is what displays to a customer coupon offers, that the customer selects coupon offers at the CDR unit 20. Column 5 lines 5-16, column 10 line 51 to column 11 line 45, and column 13 line 65 to column 14 line 4. That coupon display and customer selection of coupons at CDR 20 occurs prior to the customer purchasing any products.

Nichtberger discloses that after the customer purchases products, Nichtberger's system determines and credits the customer for applicable coupons, stating that "After the user has made his or her purchases, he or she goes to one of the checkout stations and presents his or her card to the attendant at the station. The attendant causes the card to be read by a suitable card reader (such as a UPC card scanner) and the checkout system 18 then automatically credits the customer for the coupons the customer has selected where there are corresponding purchases against which the coupons are to be applied." Nichtberger section A, describing Fig. 1, col. 5 lines 18-25.

Nichtberger section G discloses that the customer presents his identifying card (special card as described in section B) at the cash register terminal. In response to which "the store's local processor requests the corresponding list of coupon selections from the CDR unit 20."

Nichtberger does not disclose generating a customer information response signal at the POS during a customer's transaction, that, a signal based upon the customer's prior purchases during a previous shopping visit to the store.

Nichtberger column 28 line 51 through column 29 line 3 clarify that coupons are provided at CDR 20, not at the point of sale terminal (checkout/cash register). Therefore, Nichtberger's giving coupons to customers based upon the customer's selection of coupons from a previous visit does not meet the signal at the point of sale limitation of claim 8. Moreover, Nichtberger column 28 line 51 through column 29 line 3 clarify that signal received at CDR 20 based upon a customer's prior *selection of coupons* does not meet the limitation of claim 8 that the signal at the point of sale is based upon the customer's *prior purchases*. Coupon selections are not purchases.

In contrast to claim 8, Nichtberger has no circuitry at the point of sale designed to convey

to a human a signal that is based upon the customer's transaction record for transactions prior to the current transaction. In contrast to claim 8, Nichtberger discloses conveying the total charge for the current transaction, including credits based upon redeemable coupons the customer selected earlier in the customer's current shopping visit. The customer's coupon selections are not transaction data. The customer's coupon selections are not transaction data from the customer's prior shopping visits to the store. Accordingly, Nichtberger does not anticipate claim 8.

j. **CLAIM 9 - THE ANTICIPATION REJECTION SHOULD
BE REVERSED - (APPLIES TO CLAIMS 9, 13, AND 14)**

9. (Previously presented) A system for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising:
apparatus for entering unique customer identification codes from customer identification presented at the point-of-sale in said retail establishment;
a terminal for entering customer transaction data at the point-of-sale in said retail establishment;
a processor and
a memory responsive to said apparatus and said terminal for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and
circuitry associated with said memory and responsive to the entry of said individual customer's identification code during a transaction at the point-of-sale, said circuitry being operable to generate a customer information response signal at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit,
said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

Claim 9 is not anticipated by Nichtberger for the same reasons as claim 8.

**k. CLAIM 10 - THE ANTICIPATION REJECTION SHOULD
BE REVERSED**

10. (Previously presented) A method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of:

- entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

- entering customer transaction data;

- creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

- generating a customer information response at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer,

- said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and

- said response providing information at said point-of-sale derived from said database and useful for effectuating targeted customer promotion.

Claim 10 is not anticipated by Nichtberger because claim 10 requires generating a customer information response at the point-of-sale, that the said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and as noted in the discussion of claim 8, Nichtberger contains no such disclosure.

**l. CLAIM 11 - THE ANTICIPATION REJECTION SHOULD
BE REVERSED**

11. (Previously presented) A method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of:

- entering unique customer identification codes from customer identification presented at the point-of-sale in a retail establishment;
- entering customer transaction data at the point-of-sale in said retail establishment;
- creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code;
- accessing said database in response to the entry of said individual customer's identification code during a transaction at the point-of-sale;
- determining from said database the transaction history of said individual customer; and
- generating a customer information response at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit,
- said response providing information at said point-of-sale derived from said database and useful for effectuating targeted customer promotion.

Claim 11 is not anticipated by Nichtberger for the reasons stated for claim 8 (because Nichtberger does not disclose the "generating a customer information response at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit, said response providing information at said point-of-sale derived from said database.")

Moreover, claim 11 is not anticipated by Nichtberger because it recites "accessing said database in response to the entry of said individual customer's identification code during a transaction at the point-of-sale;". The database defined by claim 11 stores "transaction data from prior shopping visits" for the customer, and Nichtberger does not disclose accessing a prior

shopping visits database while the customer is transacting at the point of sale.

m. **DEPENDENT CLAIM 12 - THE ANTICIPATION
REJECTION SHOULD BE REVERSED**

12. (Original) A system according to Claim 8, wherein said circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said detection of said unique identification code of said individual customer.

Claim 12 is not anticipated by Nichtberger for the reasons applicable to claim 8.

Moreover, Nichtberger does not disclose analysis by the circuitry following detection of the customer identification at the point of sale. In contrast, claim 12 recites that "wherein said circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said detection of said unique identification code of said individual customer." Nichtberger does not disclose the claimed "customer information response signal" and therefore does not further disclose such a signal is based upon analysis by circuitry of the customer's transaction data following detection of the customer's identification code during the transaction.

n. **DEPENDENT CLAIM 13 - THE ANTICIPATION
REJECTION SHOULD BE REVERSED**

13. (Original) A system according to Claim 9, wherein said circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said entry of said individual customer's identification code.

Claim 13 is not anticipated by Nichtberger for the reasons applicable to claim 9.

Moreover, Nichtberger does not disclose analysis by the circuitry following detection of the customer identification at the point of sale. In contrast, claim 13 recites that wherein said

circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said entry of said individual customer's identification code." Nichtberger does not disclose the claimed "customer information response signal" and therefore does not further disclose such a signal following detection of the customer's identification code during the transaction.

o. **DEPENDENT CLAIM 14 - THE ANTICIPATION
REJECTION SHOULD BE REVERSED**

14. (Original) A method according to Claim 10, wherein said generating step includes the step of generating said customer information response as a function of analysis of said individual customer's transaction data following said detection of said unique identification code of said individual customer.

Claim 14 is not anticipated by Nichtberger for the reasons applicable to claim 10.

Moreover, Nichtberger does not disclose analysis by the circuitry following detection of the customer identification at the point of sale. In contrast, claim 14 recites that "wherein said generating step includes the step of generating said customer information response as a function of analysis of said individual customer's transaction data following said detection of said unique identification code of said individual customer." Nichtberger does not disclose the claimed "customer information response signal" and therefore does not further disclose such a signal following detection of the customer's identification code during the transaction.

p. **CLAIM 15 - THE REJECTION SHOULD BE REVERSED**

15. (Original) A method for providing customer services in a retail establishment, comprising the steps of:

entering into a point-of-sale terminal a unique identification code for a customer;

entering into said terminal transaction data relating to the customer's shopping transactions;

generating and maintaining a database, including the step of correlating said transaction data with said unique identification code;

responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by

supplying said response to said terminal during said current transaction in which said unique identification code is entered,

said response including information for effecting a targeted promotion to the customer.

Claim 15 is not anticipated by Nichtberger for reasons similar those stated for claim 8. Specifically, Nichtberger fails to disclose the steps of " including data in said database from prior transactions, ... to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, ". Nothing in Nichtberger discloses, or suggests, those limitations. Claim 15 is also not anticipated by Nichtberger for the same reasons as claim 11.

Moreover, claim 15 is not anticipated by Nichtberger because Nichtberger does not disclose *analyzing* the data in the customer database *during the customer's transaction*, to generate a response. In contrast, claim 15 defines this concept, reciting "responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, " That is, claim 15 further defines the analysis resulting in the response signal occurring during the transaction at the point of sale.

V. WHETHER THE REJECTIONS OF CLAIMS 17-76 UNDER 35 USC 103 AS

**OBVIOUS BASED UPON NICHTBERGER AND OFFICIAL NOTICE SHOULD
BE REVERSED - (APPLIES TO CLAIMS 17-76)**

a. THE EXAMINER'S POSITION FOR CLAIMS 17-76

In the office action rejection claims 17-76, the examiner reasons as follows.

5. Claims 17-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger in view of Official Notice.

Claims 17-41, 49-76 differ from claims 8-15 in that the claims further recite a database of prior customer purchases including the dollar amount of the purchases during an specified time period. Nichtberger teaches storing in a database the details the previous purchases transactions information (col. 12, lines 16-32). Nichtberger doesn't specifically identify the retrieved information as being the dollar amount of the purchases. Official Notice is taken that a database of prior purchases would have been obvious to include the dollar amount of the purchases in order to allow the system to keep track of the amount spent by the customers during an specified time period and will allow coupons to be targeted based on the amount spent during an specified period. For example, customer A might spent more money during the holidays and will receive coupons accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the database of customer previous purchases of Nichtberger the dollar amount in order to obtain the abovementioned advantage.

Claims 42-48 further recite a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases. Official Notice is taken that it [sic] obvious and well known for local stores to transmit information to a host server in order for the information to be shared. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and

second databases in order to obtain the abovementioned advantage. [Office action dated 11/26/2008 pages 3 and 4.]

b. CLAIM 17 - THE OBVIOUSNESS REJECTION SHOULD BE REVERSED - (APPLIES TO CLAIMS 17-76)

17. (Previously presented) A computer implemented system for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising:

a terminal for entering, during a transaction, a unique customer identification;

a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer;

circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal; and

wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification.

c. CLAIM 17 - THE EXAMINER'S ERRORS - (APPLIES TO CLAIMS 17-76)

First, the examiner errs because the examiner fails to make a prima facie case. Second, the rejection is improper.

d. CLAIM 17 - THERE IS NO PRIMA FACIE CASE - (APPLIES TO CLAIMS 17-76)

The examiner fails to make a prima facie case because the examiner has failed to assert that Nichtberger discloses all limitations of claim 17.

c. **CLAIM 17 - THERE IS NO PRIMA FACIE CASE FOR THE REASONS APPLICABLE TO CLAIM 8 CASE - (APPLIES TO CLAIMS 17-76)**

The examiner's reasons for rejection rely upon the reasons stated for claim 8. In response thereto, we noted above in discussions of claim 8 that:

There is no prima facie case because the examiner assertions do not support the examiner's conclusions that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

The examiners first assertion is that "*Nichtberger teaches that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons.*" That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

The examiner second assertion is that "*The redemption and buying habits are recorded in database 420 and is used by processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41).*" That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit."

In the examiner's only other assertion is what is stated in the office action, which cites, without explanation, Nichtberger col. 17 lines 49-61. Nichtberger col. 17 lines 49-61 discloses Nichtberger's system determining for which of the customer's product items the customer's pre selected coupons, and applying credits for those coupons to the customer's order. That assertion does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to

the customer's transaction data in shopping visits prior to the current shopping visit." Accordingly, the examiner made no prima facie case. In fact, Nichtberger discloses that its coupons are selected by the customer during the same visit that the customer uses the coupons, and Nichtberger's customer's coupon selections are not transactions.

Those reasons also apply to claim 17. Accordingly, the examiner has not made a prima facie case to reject claim 17.

f. **CLAIM 17 - THERE IS NO PRIMA FACIE CASE BECAUSE
THE OFFICIAL NOTICE IS IMPROPER FOR SEVERAL
REASONS CASE - (APPLIES TO CLAIMS 17-76)**

Further, the examiner has also not made a prima facie case because the examiner's reliance upon official notice is improper for several reasons. The examiner asserts the following based solely upon the doctrine of official notice.

that a database of prior purchases would have been obvious to include the dollar amount of the purchases in order to allow the system to keep track of the amount spent by the customers during an specified time period and will allow coupons to be targeted based on the amount spent during an specified period. For example, customer A might spent more money during the holidays and will receive coupons accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the database of customer previous purchases of Nichtberger the dollar amount in order to obtain the abovementioned advantage. [Office action mailed 11/26/2008 page 4].

First, the examiner has not in fact applied the doctrine of official notice. This is because the doctrine of official notice is limited to assertions of *facts*, and it does not apply to legal conclusions of obviousness. As stated in MPEP 2144.03:

2144.03 Reliance on Common Knowledge in the Art or “Well Known”

Prior Art [R-6]

In *>certain< circumstances >where appropriate<, ** an examiner *>may< take official notice of facts not in the record or * rely on “common knowledge” in making a rejection, however such rejections should be judiciously applied.

The examiner did not properly apply this doctrine because the examiner's alleged official notice alleges a legal conclusion, not a fact, specifically that it "would have been obvious to include the dollar amount of...". An assertion of official notice, by contrast, would have to have alleged a fact, such as that there existed a prior art database that "included the dollar amount...." To put it simply, the examiner's reasoning improperly relies upon "official notice" to in fact make a legal conclusion of obviousness. The examiner compounds that error by then making a second legal conclusion of obviousness, while treating the first legal conclusion as fact. Thus, there is in fact no "officially noticed" fact, just two improper legal conclusions.

Second, assuming *arguendo* that the panel concludes that the examiner asserted official notice meant to say that there existed a prior art database that "included the dollar amount...." of each of the customer's transactions, such official notice would also have been improper for several reasons. The most significant reason is that the examiner presents no substantial evidence that such an officially noticed assertion is fact, and therefore fails the test specified in In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Moreover, the *arguendo* officially noticed assertion (existence of a prior art customer database that also stored dollar amount of transaction) is not “capable of such instant and unquestionable demonstration as to defy dispute”. See MPEP 2144.02 citing In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) for this quote. Consequently, the *arguendo* officially noticed assertion would not be a proper officially noticed 'fact'. Finally, it defies logic that this application would be pending for so many years and would be the subject of multiple appeals, yet the examiner cannot find evidence in the record or otherwise of a fact essential to a rejection of claims. This circumstantial evidence suggests that the *arguendo* assertion is not fact.

Third, even assuming arguendo that a prior art database of customer transactions was known to include dollar amount of each of the customer's transactions (that is, giving the examiner the benefit of all doubts), the examiner has *still* not made a prima facie case. This is because the examiner's assertions, and the examiner's conclusions depending from those assertions, do not address the limitations of claim 17. From the examiner's assertions, the examiner concludes that "It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the database of customer previous purchases of Nichtberger the dollar amount in order to obtain the abovementioned advantage." However that is not what claim 17 recites. Claim 17 defines depending a customer information response signal on the "dollar amount." Specifically, claim 17 recites "circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal; *and wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification.*" The examiner has not asserted that there is such circuitry for transmitting to the point of sale a signal that depends upon the dollar mounts of the customer's prior purchases, not withstanding the impropriety of official notice. Therefore, the examiner has not made a prima facie case of obviousness of claim 17 for this additional reason.

Furthermore, the alleged rationale for the first legal conclusion in the official notice is a non sequitur and therefore improper. Specifically, the examiner' reason for asserting that "a database of prior purchases would have been obvious to include the dollar amount of the purchases" would have been obvious is because including the dollar amount of the purchases in such a database would "allow the system to keep track of the amount spent by the customers during an specified time period." That conclusion is illogical because the amount spent per item stored in such a database would enable such tracking.

Still further, the examiner's rationale for motivating a desire to "keep track of the amount spent by the customers" is to "allow coupons to be targeted based on the amount spent during an specified period." However, the prior art does not teach that; it is the applicant's specification that discloses marketing based upon dollar amount and frequency data derived from transaction

data, not the prior art. As stated in the Background section of our specification:

Beyond these check verification and risk management problems, grocery stores have a broader problem in accumulating customer information because of the emphasis on minimizing the amount of time required for a sales transaction, and the attendant impersonality of the customer relationship. Thus, it is extremely difficult to develop any meaningful customer profiles, or to identify customer groups such as regular customers and new customers who might become regular customers. If a store could accumulate more detailed customer information, customer profiles could be developed and used for targeted advertising, marketing and promotional programs.

Accordingly, a need exists for a transaction processing system for individual stores (in both single and multiple store environments) that facilitates check transactions by improving the efficiency of the check verification process, and that maintains a local customer database containing transactional information about the store's customers useful for check verification risk management, and for other customer relations purposes such as identifying new customers and profiling regular customers. [Specification pages 4 and 5.]

It is respectfully submitted that the examiner, in addition to erring in application of the doctrine of official notice in the manner explained above, is also improperly applying hindsight in view of the applicant's own specification, for example to assert legal conclusions as fact, in an attempt to justify the improper official notice. For this additional reason, there is no prima facie case, and the rejection of claim 17 is improper.

**g. CLAIM 17 - IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 17-76)**

Second, as noted above, the rejection is improper because the prior art evidence does not suggest the claimed computer implemented system for providing a signal at a point-of-sale

depending upon a customer's shopping history which comprises "circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal; and wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification."

In this regard, all Nichtberger discloses signals going to the point of sale that depend only upon the items in the customer's current transaction, namely price of those items, and values associated with coupons selected by the customer in the same shopping visit.

Nichtberger does not disclose or suggest a customer information response signal sent to the point of sale, as defined by claim 17.

Nichtberger does not disclose or suggest such a customer information response signal sent to the point of sale during the customer's transaction, as defined by claim 17.

Nichtberger does not disclose or suggest such a customer information response signal sent to the point of sale during the customer's transaction being based upon dollar amount of at least one prior purchase associated with the customer, as defined by claim 17.

For all of the foregoing reasons, the rejection of claim 17 as obvious should be reversed.

h. CLAIM 18 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART

18. (Previously presented) The system of claim 17 wherein said customer information response signal depends upon dollar amount of a plurality of prior purchases associated with said unique customer identification.

There is no prima facie case because there is no explanation in the rejection how the prior art suggests a customer information response signal that depends upon "dollar amount of a plurality of prior purchases". Moreover, Nichtberger and the alleged official notice do not suggest such a feature.

i. CLAIM 19 - IS NOT OBVIOUS IN VIEW OF THE PRIOR

ART

19. (Previously presented) The system of claim 17 wherein said customer information response signal also depends upon a frequency of prior purchases associated with said unique customer identification.

There is no prima facie case against this claim because there is no explanation in the rejection how the prior art suggests a customer information response signal that depends upon "frequency of prior purchases associated with said unique customer identification". Moreover, Nichtberger and the alleged official notice do not suggest such a feature.

j. **CLAIM 20 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART**

20. (Previously presented) The system of claim 17 wherein said terminal can also receive customer transaction data.

Nichtberger's CDR 20 cannot accept customer transaction data. To the extent the panel relies upon the CDR 20 for anything, claim 20 would not have been suggested thereby.

k. **CLAIM 21 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART**

21. (Previously presented) The system of claim 17 wherein said data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount.

There is no prima facie case against this claim because there is no assertion or explanation in the rejection that "data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount." Moreover, Nichtberger and the alleged official notice

do not suggest such features.

**1. CLAIM 22 - IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 22-26)**

22. (Previously presented) A computer implemented method for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising the steps of:

entering in a terminal, during a transaction, a unique customer identification;

storing, in a database, transaction data from prior shopping transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with said an identification of that customer;

transmitting to a point-of-sale during said transaction a customer information response signal in response to the entry of said unique customer identification at said terminal during said transaction; and

wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification.

Neither Nichtberger nor the alleged official notice suggest transmitting a customer information response signal to a point of sale during the transaction. Claim 22 recites "transmitting to a point-of-sale during said transaction a customer information response signal in response to the entry of said unique customer identification at said terminal during said transaction". That limitation is non obvious for the reasons discussed for claim 15.

Neither Nichtberger nor the alleged official notice suggest such a signal depending upon dollar amount of the customer's prior purchase. Claim 22 also recites that "said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification" and that limitation is also non obvious for the reasons discussed for claim 17.

m. **CLAIM 23 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART**

23. (Previously presented) The method of claim 22 wherein said customer information response signal depends upon dollar amount of a plurality of prior purchases associated with said unique customer identification.

There is no prima facie case because there is no explanation in the rejection how the prior art suggests a customer information response signal that depends upon "dollar amount of a plurality of prior purchases". Moreover, Nichtberger and the alleged official notice do not suggest such a feature.

n. **DEPENDENT CLAIM 24 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART**

24. (Previously presented) The method of claim 22 wherein said customer information response signal also depends upon a frequency of prior purchases associated with said unique customer identification.

There is no prima facie case because there is no explanation in the rejection how the prior art suggests a customer information response signal that depends upon "depends upon a frequency of prior purchases associated with said unique customer identification". Moreover, Nichtberger and the alleged official notice do not suggest such a feature.

o. **DEPENDENT CLAIM 25 - IS NOT OBVIOUS IN VIEW OF THE PRIOR ART**

25. (Previously presented) The method of claim 22 further comprising the step of receiving in said terminal customer transaction data.

Nichtberger's CDR 20 cannot accept customer transaction data. To the extent the panel relies upon the CDR 20 for anything, claim 20 would not have been suggested thereby.

p. **DEPENDENT CLAIM 26 - IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

26. (Previously presented) The method of claim 22 wherein said data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount.

There is no prima facie case against this claim because there is no assertion or explanation in the rejection that "data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount." Moreover, Nichtberger and the alleged official notice do not suggest such features.

q. **CLAIM 27 - IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 27-29)**

27. (Currently Amended) A computer implemented system for updating data in a customer database, comprising:

- a terminal for entering, during a transaction, a unique customer identification and transaction data for said transaction;

- a database storing transaction data for a plurality of customers from prior shopping transactions, such that transaction data regarding prior transactions of a customer are stored in association with identification of that customer; and

- circuitry responsive to the entry of said unique customer identification and said transaction data at said terminal for updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database, and for storing in said customer database the date that transaction data association with said unique customer identification was updated.

Claim 27 recites "circuitry ... for updating transaction data and a dollar amount of

purchases associated with said unique customer identification in said customer database"

Our specification discloses that a dollar amount is unrelated to the item prices, and instead is the amount tendered for a transaction. See the System Overview section, page 19, which states in pertinent part that:

A transaction terminal transmits a request (including a function code identifying the requested function together with other request data) to the transaction processor, which processes the request and returns an appropriate response.

For example, in the case of check verification, a transaction terminal is used to transmit a verification request -- the customer's check ID, the verification function code, and the dollar amount. The transaction processor processes the request, updates the customer database to reflect that transaction, and returns a customer verification status response.

As noted in the discussion of claim 17, the alleged official notice that it would have been obvious to store dollar amount of purchases associated with a customer identification in a customer database was in fact not official notice, and even if it was, it was improper and not sustainable. In addition, there is no evidence relied upon by the examiner that such a database existed in the prior art. Accordingly, the rejection of claim 27 is improper and should be reversed.

Therefore, the rejection of claim 27 is improper.

r. **DEPENDENT CLAIMS 28 AND 29 NOT OBVIOUS IN VIEW
OF THE PRIOR ART**

Dependent claims 28 and 29 are not obvious for the reasons applicable to claim 27.

s. **CLAIM 30 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 30-32)**

30. (Previously presented) A computer implemented method for

updating data in a customer database, comprising the steps of:

entering in a terminal, during a transaction, a unique customer identification and transaction data for said transaction;

storing, transaction data for a plurality of customers from prior shopping transactions, such that data regarding a prior transactions of a customer are stored in association with identification of that customer; and

updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database in response to entry of said unique customer identification and said transaction data at said terminal; and

storing in said customer database the date that transaction data association with said unique customer identification was updated.

Claim 30 recites "updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database in response to entry of said unique customer identification and said transaction data at said terminal; and" which is substantially similar to the recitation of claim 27. Therefore, the rejection of claim 30 should be reversed for the same reasons as the rejection of claim 27.

**t. DEPENDENT CLAIMS 31 AND 32 ARE NOT OBVIOUS IN
VIEW OF THE PRIOR ART**

Claims 31 and 32 are not obvious for the reasons applicable to claim 30.

**u. CLAIM 33 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 33 AND 49-65)**

33. (Previously presented) A computer implemented customer database comprising stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer said

transaction data stored in association with an identification of that customer including:

dollar amount of purchases and time period.

Claim 33 defines a computer implemented database in which transaction data stored in association with an identification of that customer includes "dollar amount of purchases and time period." Claim 33 would not have been obvious for the same reasons applicable to claim 27.

**v. CLAIM 34 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 34-39)**

34. (Previously presented) A computer implemented customer database comprising stored transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data stored in association with said identification of that customer including:

total dollar amount of purchases purchased during a period of time.

Claim 34 defines a computer implemented database in which transaction data stored in association with an identification of that customer includes "total dollar amount of purchases purchased during a period of time." Claim 34 would not have been obvious for the same reasons applicable to claim 27.

**w. DEPENDENT CLAIMS 35 AND 36 ARE NOT OBVIOUS IN
VIEW OF THE PRIOR ART**

Dependent claims 35 and 36 are not obvious for the reasons applicable to claim 34.

**x. DEPENDENT CLAIM 37 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

37. (Previously presented) The database of claim 34 wherein

said transaction data stored in association with said identification of that customer further comprises a frequency of transactions.

There is no prima facie case against this claim because there is no assertion or explanation in the rejection that data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency. Moreover, Nichtberger and the alleged official notice do not suggest such a feature.

y. **DEPENDENT CLAIM 38 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

38. (Previously presented) The database of claim 34 wherein said transaction data stored in association with said identification of that customer further comprises a frequency of transactions for a specified period of time associated with an identification of a customer.

There is no prima facie case against this claim because there is no assertion or explanation in the rejection that data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes frequency of transactions. Moreover, Nichtberger and the alleged official notice do not suggest such features.

z. **DEPENDENT CLAIM 39 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

Claim 39 is not obvious over the prior art for the reasons applicable to claim 38.

aa. **DEPENDENT CLAIM 40 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

40. (Previously presented) The system of any one of claims 17,

22, 27, 30, 33, and 34, wherein said database is local to the point-of-sale, said database stores transaction data from prior transactions for a plurality of customers such that data regarding a customer's prior transactions are stored in association with an identification of that customer, and said database is updatable from a global database concatenated from multiple store databases including said transaction data from the prior transactions of the customers at multiple stores.

There is no prima facie case for claim 40 because the office action never addressed its limitations. Claim 40 further limits prior claims to a system wherein "said database is updatable from a global database concatenated from multiple store databases including said transaction data from the prior transactions of the customers at multiple stores." The examiner has not addressed that limitation in the office action.

Moreover, claim 40 is non obvious for the reasons presented for each of the claims from which claim 40 depends; claims 17, 22, 27, 30, 33, and 34.

ab. **DEPENDENT CLAIM 41 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

Claim 41 is not obvious for the reasons applicable to claim 17.

ac. **CLAIM 42-48 ARE NOT OBVIOUS IN VIEW OF THE
PRIOR ART**

42. (Previously presented) The system of claim 17 wherein said terminal is in a first retail store, said database is a first store database, and said first store database is located at said first retail store.

The office action rejects claims 42-48 stating that:

Claims 42-48 further recite a first database at said first retail store, a second database at said second retail store and a global database for storing prior

transactions from said first and second databases. Official Notice is taken that it [sic] obvious and well known for local stores to transmit information to a host server in order for the information to be shared. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases in order to obtain the above mentioned advantage.

In reply the applicant submits that the examiner has not made a prima facie case because the taking of official notice is improper. Again, as in the previous instance in the office action of the taking of official notice, this taking of official notice is actually an improper legal conclusion. Specifically, the statements "that it [sic; is] obvious ... for local stores to transmit information to a host server." and "that it [sic; is] obvious ... for local stores to transmit information to a host server in order for the information to be shared." are both legal conclusions not susceptible to taking of official notice.

The statement "it [sic] obvious and well known for local stores to transmit information to a host server in order for the information to be shared" is a factual assertion. However, the factual assertion that it was "well known for local stores to transmit information to a host server" is not supported by any evidence, and is not the sort of fact that is open and notorious and therefore subject to the taking of official notice. Furthermore, the fact that the examiner cannot cite to evidence in support of that assertion, given the length and breadth of the proceeding on this application, is probative that the assertion is incorrect. In any case, lacking substantial evidence that it was "well known for local stores to transmit information to a host server" the dependent legal conclusions in the office action are unsupportable and rejections relying thereupon must be reversed. Accordingly, the rejections of claims 42-48 are improper and should be reversed for lack of a prima facie case.

Further, the logic in the office action is also flawed. It states (with emphasis supplied) that "Official Notice is taken that it obvious and well known for local stores to transmit information to a host server *in order for the information to be shared.*" However, it provides no

explanation why there would have been motivation in the context noted, *for the information to be shared*. Merely concluding "in order for the information to be shared" implies that such a motivation exists without supporting reasoning or evidence. The examiner further expressly relies upon the "above mentioned advantages" in concluding that "[i]t would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases." As such, even if official notice were proper, there is no rationale specified supporting motivation for providing "a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases". Therefore, there is no prima facie rejection of claims 42-48.

Furthermore, to the extent relevant, the examiner again appears to be applying improper hindsight in view of the applicants teachings. It is the applicant that teaches a multiple store configuration, and a reason for such a configuration, and a specific configuration that avoids detrimental effects of a multiple store system, not the cited prior art:

1.4. Multiple-Store Configuration.

As shown in FIGURE 1, *for businesses with multiple stores*, a check transaction processing system 110 is located in each store. One store is designated as a "host" system, and the other stores are designated as "remote" systems. The host system coordinates the global exchange of check verification data and other customer information, but otherwise operates as a local system for that store in the same manner as the remote systems. Operation as a host does not affect concurrent local operation, i. e., *host/remote status is transparent to the check transaction processing operation at each store*. [Detailed description, page 31; emphasis supplied..]

For this additional reason, that the examiner is relying upon improper hindsight in view of the applicant's claims and specification to cobble together a rejection, the examiner has not

made a prima facie case.

ad. **DEPENDENT CLAIM 43 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 43-48)**

43. (Previously presented) The system of claim 42 further comprising:

a second store database local at a second retail store, said second store database storing transaction data from prior transactions at said second store for a plurality of customers, such that data regarding a customer's prior transactions are stored in said second store database in association with a unique identification of that customer; and

a global database storing transaction data from prior transactions in both said first retail store and said second retail store.

The rejection of this claim is improper and should be reversed for the reasons stated for claim 42.

ae. **DEPENDENT CLAIM 44 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 44-48)**

44. (Previously presented) The system of claim 43 further comprising at least one data connection, said at least one data connection enabling transmission of data stored in said first store database and said second store database to said global database, and enabling transmission of data from said global database to each one of said first store database and said second store database.

The rejection of this claim is improper and should be reversed for the reasons stated for claim 42.

Moreover, there is no prima facie case because there is nothing in the office action

suggesting why it would have been obvious to enable transmission of data from said global database to each one of said first store database and said second store database.

af. **DEPENDENT CLAIM 45 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

45. (Previously presented) The system of claim 44 configured to update customer records in said first store database based upon data stored in said global database.

The rejection of this claim is improper and should be reversed for the reasons stated for claim 42.

Moreover, there is no prima facie case because there is nothing in the office action suggesting why it would have been obvious to update records in the local, first database, based upon data stored in the global database.

ag. **DEPENDENT CLAIM 46 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 46-48)**

46. (Previously presented) The system of claim 44 configured to update customer records in said first store database based upon data stored in said global database for transactions that occurred in said second retail store.

The rejection of this claim is improper and should be reversed for the reasons stated for claim 42.

Moreover, there is no prima facie case because there is nothing in the office action suggesting why it would have been obvious to update records in the local, first database (of the first store), based upon data stored in the global database from records of transactions in a store other than the first store.

ah. **DEPENDENT CLAIM 47 IS NOT OBVIOUS IN VIEW OF**

THE PRIOR ART

The rejection of this claim is improper for the same reasons specified for claim 46.

ai. **DEPENDENT CLAIM 48 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

The rejection of this claim is improper for the same reasons specified for claim 46.

aj. **DEPENDENT CLAIM 49 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 49-51)**

49. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer transaction data including a first frequency of transactions by that customer during a first period of time.

There is no prima facie case against this claim because there is no assertion or explanation in the rejection that data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes frequency of transactions, or frequency of transactions during any given time period.

Moreover, Nichtberger does not disclose or suggest either a customer information response signal or that such a signal also depends at least in part upon data stored in said first customer record, including at least a first customer first frequency value. Keep in mind that storing transactions and the time at which the transaction occurred is not storing frequency data. Nichtberger contains nothing suggesting analyzing to determine frequency of anything. Nichtberger contains nothing regarding frequency of transaction data, and does not disclose or suggest either determining or storing such frequency data.

ak. **DEPENDENT CLAIM 50 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPILES TO CLAIMS 50-51)**

50. (Previously presented) The database of claim 49, wherein

said database is structured to store in association with said identification of that customer transaction data including a second frequency of transactions by that customer during a second period of time.

Claim 50 is not obvious for the reasons stated for claim 49.

Moreover, since Nichtberger contains nothing suggesting analyzing to determine frequency of anything, it further contains nothing suggesting that the "database is structured to store ... second frequency of transactions by that customer during a second period of time" in addition to the "first frequency of transactions by that customer during a first period of time". For this additional reason, the rejection of claim 50 is improper.

al. **DEPENDENT CLAIM 51 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

51. (Previously presented) The database of claim 50, wherein said database is structured to store in association with said identification of that customer transaction data including a third frequency of transactions by that customer during a third period of time.

Following the same argument as for claims 49 and 50, Nichtberger contains nothing suggesting the database is structured to store in association with said identification of that customer transaction data additional frequencies of transactions for additional time periods, such as a third time period. For this additional reason, the rejection of claim 51 is improper.

am. **DEPENDENT CLAIMS 52-54 ARE NOT OBVIOUS IN
VIEW OF THE PRIOR ART**

52. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer transaction data including a first dollar amount for one or more transactions by that customer during a first time period.

53. (Previously presented) The database of claim 52, wherein said database is structured to store in association with said identification of that customer transaction data including a second dollar amount for one or more transactions by that customer during a second time period.

54. (Previously presented) The database of claim 53, wherein said database is structured to store in association with said identification of that customer transaction data including a third dollar amount for one or more transactions by that customer during a third time period.

As noted in the discussion of claim 17, the alleged official notice that it would have been obvious to store dollar amount of purchases associated with a customer identification in a customer database was in fact not official notice, and even if it was, it was improper and not sustainable. In addition, there is no evidence relied upon by the examiner that such a database, a database "structured to store in association with" a customer identification, first, second, or third dollar amounts for transactions, existed in the prior art. Accordingly, the rejection of claims 52-54 are improper and should be reversed.

an. **DEPENDENT CLAIM 55 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 55-57)**

Claim 55 is not obvious in view of the prior art for at least the reasons applicable to claim 33.

ao. **DEPENDENT CLAIM 56 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 56-67)**

56. (Previously presented) The database of claim 55, wherein said database is structured to store in association with said identification of that customer a date/time that said customer status changed.

Please note that specification inter alia pages 36 provide support for this claim and refers

to use of this data on page 72 in the third full paragraph.

The office action makes no prima facie case for claim 56. The office action asserts that claim 56 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 56 further defines claim 55's database to be also structured to store a "customer status" (recited in claim 55) and a "date/time" that the customer status changed, in association with the customer identification. Since these limitations are not addressed, there is no prima facie rejection of claim 56. Accordingly, the rejection of claim 56 should be reversed for this additional reason.

Moreover, Nichtberger contains no indication that a "customer status" of any kind is stored in association with identification of a customer. Therefore, Nichtberger contains no suggestion that the database is structured to store a "date/time" that the "customer status" changed.

ap. **DEPENDENT CLAIM 57 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

57. (Previously presented) The database of claim 56, wherein said database is structured to store in association with said identification of that customer a previous status of said customer.

Please note that specification inter alia pages 36 provide support for the database structured to store previous status data, stating that:

Previous Status customer's previous status (such as CAUTION prior to being rolled POSITIVE)

The specification also discusses use of that data on pages 78 and 81.

The office action makes no prima facie case for claim 57. The office action asserts that claim 57 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 57 further defines claim 56's database to be also structured to store a

"previous status of said customer" in addition to said "customer status" and "date/time" that the customer status changed, all in association with the customer identification. Since these limitations are not addressed, there is no prima facie rejection of claim 57. Accordingly, the rejection of claim 57 should be reversed for this additional reason.

Moreover, Nichtberger contains no indication that a "customer status" of any kind is stored in association with identification of a customer. Therefore, Nichtberger contains no suggestion that the database is structured to store a "customer status"; a "date/time" that the "customer status" changed; or "previous status" of the customer. Therefore, the rejection of this claim should be reversed.

aq. **DEPENDENT CLAIM 58 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

Claim 58 is not obvious for at least the reasons applicable to claim 33.

ar. **DEPENDENT CLAIM 59 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

59. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a transfer date/time indicating when the customer's record was last written to disk.

The specification page 35 supports this "transfer date/time" database structure limitation, stating in relevant part:

Transfer Date/Time: Date/time the customer record was last accessed and updated (written to disk), used in host/remote transfers for global update (transfers from host to remote generally do not affect this date).

Specification page 103-106 explains how the disclosed embodiment uses that data.

The office action makes no prima facie case for claim 59. The office action asserts that claim 59 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 59 further defines claim 33's database to be also structured to store in association with an identification of the customer a transfer date/time indicating when the customer's record was last written to disk. Since these limitations are not addressed, there is no prima facie rejection of claim 59. Accordingly, the rejection of claim 59 should be reversed for this additional reason.

Moreover, Nichtberger contains no indication that the most recent time of access and update of a customer record is significant. Therefore, Nichtberger contains no suggestion that a database is structured to store "transfer date/time indicating when the customer's record was last written to disk."

as. **DEPENDENT CLAIM 60 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

60. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer an access date/time indicating when the customer's record was last accessed and updated.

The specification pages 36 and 40 supports this "access date/time" database structure limitation, both stating in relevant part:

Access Date/Time Last date/time the customer record was accessed and updated (a query function does not change the access date/time)

Specification page 103-106 explains how the disclosed embodiment uses that data.

The office action makes no prima facie case for claim 60. The office action asserts that claim 60 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 60 further defines claim 33's database to be also structured to store in association with the identification of the customer "an access date/time indicating when the customer's record was last accessed and updated." Since these limitations are not addressed, there is no prima facie rejection of claim 60. Accordingly, the rejection of claim 60 should be reversed for this additional reason.

Moreover, Nichtberger contains no indication that the most recent time of access and update of a customer record is significant. Therefore, Nichtberger contains no suggestion that a database is structured to store "access date/time indicating when the customer's record was last accessed and updated."

at. **DEPENDENT CLAIM 61 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART - (APPLIES TO CLAIMS 61-62)**

61. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a total number of transactions since a last global update, said global update updating data stored in association with said identification of that customer based upon data stored in association with said identification of that customer in a second database.

The Brief Description of the Drawings section of the specification refers to "global update" in association with Figs. 6 and 9, and section 2.5 of the specification (see page 17) is titled "Global Update". Section 2.5 begins on specification page 50

The office action makes no prima facie case for claim 61. The office action asserts that claim 61 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 61 further defines claim 33's database to be also "structured to store in association with said identification of that customer a total number of transactions since a last global update". Since these limitations are not addressed in the office action, there is no prima

facie rejection of claim 61. Accordingly, the rejection of claim 61 should be reversed for this additional reason.

Moreover, Nichtberger does not disclose or suggest a remote database, transferring data between databases, or a global update as defined by claim 61. Therefore, Nichtberger does not also suggest the claimed limitation of a database structured to store "a total number of transactions since a last global update." Therefore, the rejection of this claim should be reversed.

au. **DEPENDENT CLAIM 62 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

62. (Previously presented) The database of claim 61, wherein said database is structured to store in association with said identification of that customer a total dollar volume since said last global update.

The specification page 36 discloses total dollar volume since last global update as a field in the customer record, stating:

\$Amount Since Transfer	Total dollar volume since the last
global transfer	

Use of this database field is discussed in the Global Update section of the specification, section 2.5, starting on page 50, as noted for claim 61.

The office action makes no prima facie case for claim 62 for the reasons stated for claim 61 and also because it does not address the "total dollar volume since said last global update" limitation of claim 62.

Nichtberger does not disclose or suggest a database structured to store "total dollar volume since said last global update" and for this additional reason does not suggest claim 62.

av. **DEPENDENT CLAIM 63 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

Claim 63 is not obvious for the reasons applicable to claim 33.

aw. **DEPENDENT CLAIM 64 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

64. (Previously presented) The database of claim 33, wherein said database is structured so that it is indexed at least by status.

See specification page 36, last 2 lines. Indexing has had a well known meaning in the context of data structures since prior to when this application was filed.

The office action makes no prima facie case for claim 64. The office action asserts that claim 64 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 66 further defines claim 33's database to be also structured so that a status field is indexed. Since this limitation is not addressed in the office action, there is no prima facie rejection of claim 64. Accordingly, the rejection of claim 64 should be reversed for this additional reason.

Moreover, Nichtberger does not disclose or suggest indexing, a status field, and does not contain anything suggesting indexing such a non existent status field. Therefore, Nichtberger does not also suggest the claimed limitation of a database structured to store "said database is structured so that it is indexed at least by status." Therefore, the rejection of this claim should be reversed.

ax. **DEPENDENT CLAIM 65 IS NOT OBVIOUS IN VIEW OF
THE PRIOR ART**

65. (Previously presented) The database of claim 33, wherein said database is structured so that it is indexed at least by transfer date.

See specification page 36, last 2 lines. Indexing has had a well known meaning in the context of data structures since prior to when this application was filed. It was also well known that indexes could be used in conjunction or separately for ordering a sequence of operations.

Page 52 first full paragraph and page 104 first full paragraph, for examples, describes how the disclosed embodiment uses indexing of the transfer data field.

The office action makes no prima facie case for claim 65. The office action asserts that claim 65 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 66 further defines claim 33's database to be also structured so that a transfer date field is indexed. Since this limitation is not addressed in the office action, there is no prima facie rejection of claim 65. Accordingly, the rejection of claim 64 should be reversed for this additional reason.

Moreover, Nichtberger does not disclose or suggest indexing, a status field, and does not contain anything suggesting indexing such a non existent status field. Therefore, Nichtberger does not also suggest the claimed limitation of a database structured to store "said database is structured so that it is indexed at least by transfer date." Therefore, the rejection of this claim should be reversed.

ay. **CLAIM 66 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 66-76)**

66. (Previously presented) A computer implemented system comprising:

computer implemented customer database comprising stored transaction data from prior point-of-sale transactions, said stored transaction data comprising:

(1) data for a first customer such that data regarding said first customer's prior transactions are stored in a first customer record associating a first customer identification of said first customer with at least a first customer first dollar amount; and

(2) data for a second customer such that data regarding said second customer's prior transactions are stored in a second customer record associating a second customer identification of said second customer with at least a second customer first dollar amount;

a point of sale terminal;

a digital data processor;

and wherein said system is programmed to respond to transaction information received from the point of sale terminal including said first customer identification by identifying said first customer record in said database, and returning to said point of sale terminal a first customer information response signal;

wherein a value of said first customer information response signal depends at least in part upon data stored in said first customer record, including at least said first customer first dollar amount.

The office action makes no prima facie case for claim 66.

The office action asserts that claim 66 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. There is no prima facie case for the reasons explained for claim 8, which is that the examiner assertions do not support the examiner's conclusions that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit." In contrast, claim 66 defines such a signal, reciting:

wherein said system is programmed to respond to transaction information received from the point of sale terminal including said first customer identification by identifying said first customer record in said database, and returning to said point of sale terminal *a first customer information response signal*;

wherein a value of said first customer information response signal depends at least in part upon data stored in said first customer record, including at least said first customer first dollar amount.

Claim 66 further defines responding to data received from the point of sale by returning to the point of sale a customer information response signal having a value that depends on a

dollar amount stored in a record of a prior transaction for that customer. As noted above, a "customer information response signal" is a signal returned to the transaction terminal that is a response to a signal sent from the transaction terminal identifying the customer, and that depends upon transaction data in the database for the customer's prior shopping visits prior to the current shopping visit.

There is also no prima facie case because the office action fails to address the limitation that the "response signal depends at least in part upon ...said first customer first dollar amount." First, the taking of official notice that a "database of prior purchases would have ...include[d] the dollar amount of the purchases" is improper and not sustainable for the many reasons noted in discussion of claim 17 (legal conclusion instead of factual assertion, lack of reasoning, etc, see claim 17). Further, even in light most favorable to the examiner, the office action contains no discussion of returning a signal to the point of sale that depends upon the dollar amount of a prior purchase, and there is no rationale in the office action addressing that concept.

Claim 66 is not obvious in view of Nichtberger because Nichtberger contains nothing suggesting claimed signal returned to the point of sale, which depends upon dollar value of a prior purchase by the consumer at the point of sale terminal.

az. **CLAIM 67 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 67-68)**

67. (Previously presented) The system of claim 66 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer second dollar amount.

Claim 67 is not obvious for the reasons specified for claim 66 and also because nothing in Nichtberger would suggest a signal depending on two different dollar amounts in the record of the customer at the point of sale terminal.

ba. **CLAIM 68 IS NOT OBVIOUS IN VIEW OF THE PRIOR**

ART

Claim 68 is not obvious for the reasons specified for claim 67.

**bb. CLAIM 69 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART**

69. (Previously presented) The system of claim 66 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer first frequency value.

The office action makes no prima facie case for claim 69. The office action asserts that claim 69 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 69 further defines claim 66's signal to also depend upon data stored in said first customer record, including at least a first customer first frequency value. Since this limitation is not addressed in the office action, there is no prima facie rejection of claim 69. Accordingly, the rejection of claim 69 should be reversed for this additional reason.

Moreover, Nichtberger does not disclose or suggest either a customer information response signal or that such a signal also depends at least in part upon data stored in said first customer record, including at least a first customer first frequency value. Keep in mind that storing transactions and the time at which the transaction occurred is not storing frequency data. Nichtberger contains nothing suggesting analyzing to determine frequency of anything. Nichtberger contains nothing regarding frequency of transaction data, and does not disclose or suggest either determining or storing such frequency data.

**bc. CLAIM 70 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 70-71)**

70. (Previously presented) The system of claim 69 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first

customer second frequency value.

Moreover, since Nichtberger contains nothing suggesting analyzing to determine frequency of anything, it further contains nothing suggesting that the database stores two frequencies in a customer record and depends a signal to the point of sale on those two frequencies. For this additional reason, the rejection of claim 70 is improper.

**bd. CLAIM 71 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART**

71. (Previously presented) The system of claim 70 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer third frequency value.

Following the same argument as for claims 69 and 70, Nichtberger contains nothing suggesting the database is structured to store in association with said identification of that customer transaction data additional frequencies of transactions for additional time periods, such as a third time period. For this additional reason, the rejection of claim 51 is improper.

**be. CLAIM 72 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 72-73)**

Claim 72 is not obvious in view of the prior art for the reasons stated for claims 67 and 69.

**bf. CLAIM 73 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART**

Claim 73 is not obvious in view of the prior art for the reasons stated for claims 70 and 72.

bg. **CLAIM 74 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART - (APPLIES TO CLAIMS 74-75)**

Claim 74 is not obvious for the reasons applicable to claim 66.

bh. **CLAIM 75 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART**

Claim 75 is not obvious for the reasons applicable to claim 74.

bi. **CLAIM 76 IS NOT OBVIOUS IN VIEW OF THE PRIOR
ART**

76. (Previously presented) The system of claim 66 wherein said signal also depends at least in part upon data stored in said first customer record, including at least a first customer first time value.

The office action makes no prima facie case for claim 76. The office action asserts that claim 76 differs from claims 8-15 only in defining a database storing a dollar amount. Office action pages 3 and 4. Claim 76 further defines claim 66's signal to also depend upon data stored in the customer record including a first time value. Since this limitation is not addressed in the office action, there is no prima facie rejection of claim 76. Accordingly, the rejection of claim 76 should be reversed for this additional reason.

Moreover, Nichtberger does not disclose or suggest a customer information response signal sent to the point of sale, and therefore also does not disclose or suggest that that signal depends upon a first time value stored in the customer's record.

I. **37 CFR 41.37 (c)(1)(viii) Claims Appendix**

APPENDIX I is attached which contains a copy of the claims involved in the appeal.

J. **37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

There is no evidence submitted herewith under 37 CFR 41.37 (c)(1)(ix).

K 37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix

There is a related proceedings appendix.

Attachment 1 is a copy of the judgement in the interference 104607 involving this application.

Attachment 2 is a copy of the DECISION ON APPEAL in appeal docket no: 2004-0786.

VI. 37 CFR 41.37 (c)(2)

The applicant has not submitted any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

VII. 37 CFR 41.37 (d)

This appeal brief complies with all the requirements of paragraph (c) of this section.

VIII. 37 CFR 41.37 (e)

The filing of this appeal brief is timely.

1-26-2009

DATE

Respectfully Submitted,

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RAN

Printed: January 26, 2009 (5:37pm)

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IX.

37 CFR 41.37 (c)(1)(viii) CLAIMS APPENDIX

1.-7. Canceled.

8. (Previously presented) A system for accumulating customer transaction data at the point-of-sale in a retail establishment and for effectuating customer promotion on the basis thereof, comprising:

a terminal for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

means for allowing entry of customer transaction data;

a processor and

a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer,

said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and

said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

9. (Previously presented) A system for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising:

apparatus for entering unique customer identification codes from customer identification presented at the point-of-sale in said retail establishment;

a terminal for entering customer transaction data at the point-of-sale in said retail establishment;

a processor and

a memory responsive to said apparatus and said terminal for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry associated with said memory and responsive to the entry of said individual customer's identification code during a transaction at the point-of-sale, said circuitry being operable to generate a customer information response signal at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit,

said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

10. (Previously presented) A method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of:

entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

entering customer transaction data;

creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

generating a customer information response at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer,

said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and

said response providing information at said point-of-sale derived from said database and useful for effectuating targeted customer promotion.

11. (Previously presented) A method for accumulating and using customer transaction data at the point-of-sale in a retail establishment comprising the steps of:

entering unique customer identification codes from customer identification presented at the point-of-sale in a retail establishment;

entering customer transaction data at the point-of-sale in said retail establishment;

creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code;

accessing said database in response to the entry of said individual customer's identification code during a transaction at the point-of-sale;

determining from said database the transaction history of said individual customer; and
generating a customer information response at the point-of-sale representative of said individual customer's transaction history prior to the current shopping visit,

said response providing information at said point-of-sale derived from said database and useful for effectuating targeted customer promotion.

12. (Original) A system according to Claim 8,
wherein said circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said detection of said unique identification code of said individual customer.

13. (Original) A system according to Claim 9,
wherein said circuitry generates said customer information response signal as a function of analysis by said circuitry of said individual customer's transaction data following said entry of said individual customer's identification code.

14. (Original) A method according to Claim 10,
wherein said generating step includes the step of generating said customer information response as a function of analysis of said individual customer's transaction data following said detection of said unique identification code of said individual customer.

15. (Original) A method for providing customer services in a retail establishment, comprising the steps of:

entering into a point-of-sale terminal a unique identification code for a customer;

entering into said terminal transaction data relating to the customer's shopping transactions;

generating and maintaining a database, including the step of correlating said transaction data with said unique identification code;

responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by

supplying said response to said terminal during said current transaction in which said unique identification code is entered,

said response including information for effecting a targeted promotion to the customer.

16. (Canceled)

17. (Previously presented) A computer implemented system for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising:

a terminal for entering, during a transaction, a unique customer identification;

a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer;

circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal; and

wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification.

18. (Previously presented) The system of claim 17 wherein said customer information response signal depends upon dollar amount of a plurality of prior purchases associated with said unique customer identification.

19. (Previously presented) The system of claim 17 wherein said customer information response signal also depends upon a frequency of prior purchases associated with said unique customer identification.

20. (Previously presented) The system of claim 17 wherein said terminal can also receive customer transaction data.

21. (Previously presented) The system of claim 17 wherein said data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount.

22. (Previously presented) A computer implemented method for providing a signal at a point-of-sale depending upon a customer's shopping history, comprising the steps of:
entering in a terminal, during a transaction, a unique customer identification;
storing, in a database, transaction data from prior shopping transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with said an identification of that customer;
transmitting to a point-of-sale during said transaction a customer information response signal in response to the entry of said unique customer identification at said terminal during said transaction; and
wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification.

23. (Previously presented) The method of claim 22 wherein said customer

information response signal depends upon dollar amount of a plurality of prior purchases associated with said unique customer identification.

24. (Previously presented) The method of claim 22 wherein said customer information response signal also depends upon a frequency of prior purchases associated with said unique customer identification.

25. (Previously presented) The method of claim 22 further comprising the step of receiving in said terminal customer transaction data.

26. (Previously presented) The method of claim 22 wherein said data regarding said individual customer's prior transactions stored in association with said individual customer's identification in said database includes transaction frequency and dollar amount.

27. (Currently Amended) A computer implemented system for updating data in a customer database, comprising:

a terminal for entering, during a transaction, a unique customer identification and transaction data for said transaction;

a database storing transaction data for a plurality of customers from prior shopping transactions, such that transaction data regarding prior transactions of a customer are stored in association with identification of that customer; and

circuitry responsive to the entry of said unique customer identification and said transaction data at said terminal for updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database, and for storing in said customer database the date that transaction data association with said unique customer identification was updated.

28. (Previously presented) The system of claim 27 wherein said circuitry updates said transaction data associated with said unique customer identification during said

transaction.

29. (Previously presented) The system of claim 27 wherein said database also stores a time of day that said transaction data was updated in association with said unique customer identification.

30. (Previously presented) A computer implemented method for updating data in a customer database, comprising the steps of:

entering in a terminal, during a transaction, a unique customer identification and transaction data for said transaction;

storing, transaction data for a plurality of customers from prior shopping transactions, such that data regarding a prior transactions of a customer are stored in association with identification of that customer; and

updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database in response to entry of said unique customer identification and said transaction data at said terminal; and

storing in said customer database the date that transaction data association with said unique customer identification was updated.

31. (Previously presented) The method of claim 30 wherein said circuitry updates said transaction data associated with said unique customer identification during said transaction.

32. (Previously presented) The method of claim 30 further comprising the step of storing in said database a time of day that said transaction data stored in association with said unique identification was updated.

33. (Previously presented) A computer implemented customer database comprising stored transaction data from prior point-of-sale transactions for a plurality of

customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer said transaction data stored in association with an identification of that customer including:

dollar amount of purchases and time period.

34. (Previously presented) A computer implemented customer database comprising stored transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data stored in association with said identification of that customer including:

total dollar amount of purchases purchased during a period of time.

35. (Previously presented) The database of claim 34 wherein said period of time is one of a day and a week.

36. (Previously presented) The database of claim 34 wherein said transaction data stored in association with said identification of that customer further comprises a number of transactions associated with an identification of a customer.

37. (Previously presented) The database of claim 34 wherein said transaction data stored in association with said identification of that customer further comprises a frequency of transactions.

38. (Previously presented) The database of claim 34 wherein said transaction data stored in association with said identification of that customer further comprises a frequency of transactions for a specified period of time associated with an identification of a customer.

39. (Previously presented) The database of claim 38 wherein said specified period of time is one of a day and a week.

40. (Previously presented) The system of any one of claims 17, 22, 27, 30, 33, and 34, wherein said database is local to the point-of-sale, said database stores transaction data from prior transactions for a plurality of customers such that data regarding a customer's prior transactions are stored in association with an identification of that customer, and said database is updatable from a global database concatenated from multiple store databases including said transaction data from the prior transactions of the customers at multiple stores.

41. (Previously presented) The system of claim 17 wherein said database stores the date that transaction data association with said unique customer identification was updated.

42. (Previously presented) The system of claim 17 wherein said terminal is in a first retail store, said database is a first store database, and said first store database is located at said first retail store.

43. (Previously presented) The system of claim 42 further comprising:
a second store database local at a second retail store, said second store database storing transaction data from prior transactions at said second store for a plurality of customers, such that data regarding a customer's prior transactions are stored in said second store database in association with a unique identification of that customer; and
a global database storing transaction data from prior transactions in both said first retail store and said second retail store.

44. (Previously presented) The system of claim 43 further comprising at least one data connection, said at least one data connection enabling transmission of data stored in said first store database and said second store database to said global database, and enabling transmission of data from said global database to each one of said first store database and said second store database.

45. (Previously presented) The system of claim 44 configured to update

customer records in said first store database based upon data stored in said global database.

46. (Previously presented) The system of claim 44 configured to update customer records in said first store database based upon data stored in said global database for transactions that occurred in said second retail store.

47. (Previously presented) The system of claim 46 configured to update customer records in said first store database based upon data transmitted to said global database from said second store database for transactions that occurred in said second retail store.

48. (Previously presented) The system of claim 46 configured to update customer records in said second store database based upon data stored in said global database for transactions that occurred in said first retail store.

49. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer transaction data including a first frequency of transactions by that customer during a first period of time.

50. (Previously presented) The database of claim 49, wherein said database is structured to store in association with said identification of that customer transaction data including a second frequency of transactions by that customer during a second period of time.

51. (Previously presented) The database of claim 50, wherein said database is structured to store in association with said identification of that customer transaction data including a third frequency of transactions by that customer during a third period of time.

52. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer transaction data including a first dollar amount for one or more transactions by that customer during a first time

period.

53. (Previously presented) The database of claim 52, wherein said database is structured to store in association with said identification of that customer transaction data including a second dollar amount for one or more transactions by that customer during a second time period.

54. (Previously presented) The database of claim 53, wherein said database is structured to store in association with said identification of that customer transaction data including a third dollar amount for one or more transactions by that customer during a third time period.

55. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a customer status.

56. (Previously presented) The database of claim 55, wherein said database is structured to store in association with said identification of that customer a date/time that said customer status changed.

57. (Previously presented) The database of claim 56, wherein said database is structured to store in association with said identification of that customer a previous status of said customer.

58. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a user flag.

59. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a transfer date/time indicating when the customer's record was last written to disk.

60. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer an access date/time indicating when the customer's record was last accessed and updated.

61. (Previously presented) The database of claim 33, wherein said database is structured to store in association with said identification of that customer a total number of transactions since a last global update, said global update updating data stored in association with said identification of that customer based upon data stored in association with said identification of that customer in a second database.

62. (Previously presented) The database of claim 61, wherein said database is structured to store in association with said identification of that customer a total dollar volume since said last global update.

63. (Previously presented) The database of claim 33, wherein said database is structured so that it is indexed at least by customer identification.

64. (Previously presented) The database of claim 33, wherein said database is structured so that it is indexed at least by status.

65. (Previously presented) The database of claim 33, wherein said database is structured so that it is indexed at least by transfer date.

66. (Previously presented) A computer implemented system comprising:
computer implemented customer database comprising stored transaction data from prior point-of-sale transactions, said stored transaction data comprising:

(1) data for a first customer such that data regarding said first customer's prior transactions are stored in a first customer record associating a first customer identification of said

first customer with at least a first customer first dollar amount; and

(2) data for a second customer such that data regarding said second customer's prior transactions are stored in a second customer record associating a second customer identification of said second customer with at least a second customer first dollar amount;

a point of sale terminal;

a digital data processor;

and wherein said system is programmed to respond to transaction information received from the point of sale terminal including said first customer identification by identifying said first customer record in said database, and returning to said point of sale terminal a first customer information response signal;

wherein a value of said first customer information response signal depends at least in part upon data stored in said first customer record, including at least said first customer first dollar amount.

67. (Previously presented) The system of claim 66 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer second dollar amount.

68. (Previously presented) The system of claim 67 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer third dollar amount.

69. (Previously presented) The system of claim 66 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer first frequency value.

70. (Previously presented) The system of claim 69 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer second frequency value.

71. (Previously presented) The system of claim 70 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer third frequency value.

72. (Previously presented) The system of claim 67 wherein a value of said first customer information response signal also depends at least in part upon data stored in said first customer record, including at least a first customer first frequency value.

73. (Previously presented) The system of claim 72 wherein said signal also depends at least in part upon data stored in said first customer record, including at least a first customer second frequency value.

74. (Previously presented) The system of claim 66 wherein said signal also depends at least in part upon data stored in said first customer record, including at least a first customer first status value.

75. (Previously presented) The system of claim 74 wherein said signal also depends at least in part upon data stored in said first customer record, including at least a first customer first flag value.

76. (Previously presented) The system of claim 66 wherein said signal also depends at least in part upon data stored in said first customer record, including at least a first customer first time value.

X. **37 CFR 41.37 (c)(1)(ix) EVIDENCE APPENDIX**

No evidence is submitted.

IX. **37 CFR 41.37 (e)(1)(x) RELATED PROCEEDINGS APPENDIX**

Attachment 1 is a copy of the judgement in the interference 104607 involving this application.

Attachment 2 is a copy of the DECISION ON APPEAL in appeal docket no: 2004-0786.

RAN

Printed: January 26, 2009 (5:37pm)

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The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper **B**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MICHAEL R. O'BRIEN, GEORGE W. OFF
and TIMOTHY L. CHERNEY,

DEC 13 2000

Junior Party,
(Application 08/498,654),

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

DAVID W. DEATON and RODNEY G. GABRIEL,

Senior Party
(Application 08/935,116).

Patent Interference No. 104,607

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

JUDGMENT PURSUANT TO 37 CFR § 1.662

Upon consideration of O'BRIEN'S RESPONSE TO ORDER MAIL
OCTOBER 18, 2000 (Paper 33), it is

ORDERED that judgment on priority as to Count 1
(Paper 1, page 46), the sole count in the interference, is

awarded against junior party MICHAEL R. O'BRIEN, GEORGE W. OFF and TIMOTHY L. CHERNEY.

FURTHER ORDERED that junior party MICHAEL R. O'BRIEN, GEORGE W. OFF and TIMOTHY L. CHERNEY is not entitled to a patent containing claims 1, 3-6, 8, 10, 13-21, 23-24, 27-35, 37-43 and 45-67 (corresponding to Count 1) of application 08/498,654, filed 3 July 1995.

FURTHER ORDERED that a copy of this paper shall be made of record in files of application 08/498,654 and application 08/935,116.

FURTHER ORDERED that if there is a settlement agreement not already filed with the board, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

mck

FRED E. MCKELVEY, Senior)
Administrative Patent Judge)

Richard E. Schaffer

RICHARD E. SCHAFER)
Administrative Patent Judge)

Sally C. Medley

SALLY C. MEDLEY)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

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201930US25X (cont)

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RECEIVED: 9-13-04
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

Ex parte DAVID W. DEATON
and ROBERT SCOTT WOOD

DOCKETING DEPT.

Initials/Date Docketed: 9-13-04

Appeal No. 2004-0786

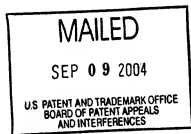
Type of Resp(s): Appeal to CAFC

Application No. 08/935,116

Due Date(s): Reg for Rehearing

11-8-04

HEARD: August 18, 2004



Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 8-39, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a system, method and database for processing transactions. An understanding of the

invention can be derived from a reading of exemplary claims 8 and 33, which are reproduced as follows:

8. A system for accumulating customer transaction data at the point-of-sale in a retail establishment and for effectuating customer promotion on the basis thereof, comprising:

a terminal for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

means for allowing entry of customer transaction data;

a processor and a memory responsive to said terminal and said means for allowing entry for creating a database for a plurality of the retail establishment's customer's transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion.

33. A computer implemented customer database comprising stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data including:

dollar amount of purchases and time period.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Goldman et al. (Goldman)	Re. 30, 580	Apr. 14, 1981
Creekmore	4,109,238	Aug. 22, 1978
Tai	4,908,761	Mar. 13, 1990
Off et al. (Off)	4,910,672	Mar. 20, 1990
Bigari	5,010,485	Apr. 23, 1991
Deaton et al. (Deaton '010)	5,201,010	Apr. 6, 1993
Deaton et al. (Deaton '196)	5,305,196	Apr. 19, 1994
Deaton et al. (Deaton '560)	5,592,560	Jan. 7, 1997

Claims 33-39 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Claims 8, 9, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Creekmore.

Claims 33-39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goldman.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off.

Claims 10, 11 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off and Tai.

Claims 17-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and Bigari.

Claims 8, 9, 12 and 13 stand rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent 5,305,196.

Claims 10, 11 and 14 stand rejected under the doctrine of obviousness-type double patenting over claims 18 and 26 of U.S. Patent 5,201,010 in view of Tai.

Claims 17-32 stand rejected under the doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent 5,592,560.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer¹ (Paper No. 35, mailed April 19, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief² (Paper No. 25, filed February 4, 2002) reply brief (Paper No. 28, filed April 29, 2002) and supplemental reply brief³ (Paper No. 37, filed June 26, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

¹ Supplemental examiner's answer.

² Substitute appeal brief.

³ Response to the supplemental examiner's answer.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of non-statutory subject matter, anticipation, obviousness and obviousness-type double patenting, relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we affirm-in-part, and enter a new ground of rejection, under 37 CFR § 1.196(b), of claim 33 under 35 U.S.C. § 102.

We begin with the rejection of claims 33-39 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. The examiner's position (answer, page 2) is that the claims are drawn to non-functional descriptive matter, and that the invention recites stored transaction data which does not produce a useful, concrete or tangible result. Appellants assert (brief, page 35) that the claims define a statutory novel composition of matter whose utility resides in the ability of the computer system to retrieve representations of the data and the associations between

the data stored therein to perform the credit verifications and marketing functions disclosed in the application. Appellants add that the computer implemented customer database is clearly useful to the merchant, and its disclosed uses are useful, concrete and tangible, being for credit determination and targeted customer marketing.

From our review of claim 33, we find that the claim is directed to a computer implemented customer database having stored transaction data from prior point-of-sale transactions for a plurality of customers. The claim additionally recites that data regarding a customer's prior transactions are stored in association with an identification of the customer and that the transaction data includes the dollar amount of purchases and time period. From our analysis of the language of claim 33, we find that the computer implemented customer database is useful to a merchant, as the database has stored customer data. We additionally find that the database with customer transaction information is tangible as it contains specific customer transaction information. Moreover, we find that the storing of the dollar amount of purchases and time period is concrete, as the dollar amounts of different transactions for each customer are stored. From all of the above, we find independent claim 33

to be statutory under 35 U.S.C. § 101. Turning to independent claim 34, we find claim 34 to be statutory for the same reasons as claim 33. Accordingly, the rejection of claims 33-39 under 35 U.S.C. § 101 as being drawn to descriptive, non-functional subject matter is reversed.

We turn next to the rejection of claims 8, 9, 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by Creekmore. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

The examiner's position is set forth on pages 2 and 3 of the answer.

Appellants assert (brief, page 11) that "Creekmore does not disclose a system for entering unique customer identification codes from customer identification presented at the point-of-sale and for accumulating transaction data at the point-of-sale, as claimed." It is argued that because the terminal 13 of Creekmore is located near the checkout lanes of a grocery store, it is not located at the point of sale. It is further argued (brief, page 14) that the data entry of columns 5 and 6 of Creekmore refers to entering customer identification codes, and does not relate to the entry of transaction data as recited in claim 8.

From our review of Creekmore's disclosure, we find that Creekmore discloses (col. 5, lines 18-28) that "the input terminal 13 . . . may be positioned at any convenient point-of-use location such as a location near the checkout lanes of a grocery store. When a customer desires to undertake a particular checking function, such as paying presently-unknown amount for the purchase of groceries, he inserts his identification card 25 into a slot 26 provided on the side 27 of the input terminal. The customer next places a blank check 28 face-down on the check tray 29, and then slides the check tray into the opening provided in the front face 30 of the input terminal." Creekmore further discloses (col. 5, lines 57 and 58) that in this example, it is

presumed that a customer has not passed through the checkout lane of the store.

From the disclosure of Creekmore, we agree with appellants. that a customer of Creekmore will first go to the check verification terminal for check approval, and then go to the checkout. Thus, Creekmore does not disclose that the terminal for entering the unique customer codes is located at the point-of-sale, as required by claim 8. We agree with the examiner that Creekmore discloses storing customer data relating to prior transactions, because the number of checks cashed within a particular period and their dollar amounts relates to the customer's prior transactions (col. 7, lines 19-21 and col. 7, lines 64-68 and col. 10, lines 48-56). In addition, Creekmore discloses that the information relating to the dollar amount of the check is entered into the terminal by the user (col. 3, lines 6-10 and col. 10, lines 52 and 53), and that a nightly update routine is used to generate various reports and records, and various statistical reports as desired (col. 10, lines 48-56). However, we are not persuaded by the examiner's assertion (answer, page 8) that point-of-use is equivalent to point-of-sale. Firstly, Creekmore's disclosure that the terminal is near the checkout and that the customer goes to the checkout after

obtaining check approval makes clear that the terminal is not at the point-of-sale. Secondly, the examiner's arguments regarding equivalence are misplaced as the rejection is not based upon 35 U.S.C.

§ 103(a). By asserting equivalence, the examiner in effect is taking the position that the reference does not teach the claimed subject matter, but that an artisan would have recognized the equivalence between the disclosure of Creekmore and the claim, and considered the substitution to have been obvious. From all of the above, we conclude that Creekmore does not anticipate claim 8. Accordingly, the rejection of claim 8 under 35 U.S.C. § 102(b) is reversed. In addition, for the same reasons, we reverse the rejection of independent claim 9, as well as dependent claims 12 and 13.

We turn next to the rejection of claims 33-39 as being anticipated by Goldman. The examiner's position is set forth on pages 3 and 4 of the answer. Appellants assert (brief, page 15) that with respect to claim 33, "Goldman et al. does not disclose a computer implemented customer database comprising stored transaction data wherein the transaction data includes 'dollar amount of purchases and time period' as recited in claim 33."

From our review of Goldman we find that although Goldman discloses (col. 5, lines 24-54) a table providing input to the cashier as to whether the customer's check should be accepted, we find that Goldman does not disclose that the stored transaction data includes the dollar amount of purchases. We agree with the examiner that Goldman discloses (in the table of column 5) the cashing of a number of checks during a current period (col. 11, lines 56-64). However, claim 33 requires more than the storing of data relating to the time period of prior transactions. The claim requires that the dollar amount of the transactions are stored in the customer database. We do not agree with the examiner that a worthless check having no value is a disclosure of a dollar amount of the transaction. A worthless check has no dollar amount of value, even if the transaction had a dollar amount. Because Goldman does not disclose storing the dollar amount of prior transactions in the customer database, we find that Goldman does not anticipate claim 33. Accordingly, the rejection of claim 33 under 35 U.S.C. § 102(b) is reversed.

In addition, because independent claim 34 also requires that the stored transaction data includes the dollar amount of the transaction, the rejection of claim 34, and claims 35-39, dependent therefrom, under 35 U.S.C. § 102(b) is reversed.

We turn next to the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off. Appellants assert (brief, page 18) that claims 15 and 16 stand or fall together. Accordingly, we select claim 15 as representative of the group. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying

with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 4 and 5) is that Creekmore does not disclose:

Responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer.

To make up for this deficiency of Creekmore, the examiner turns to Off for a teaching of these features, relying upon col. 9, lines 15-60 of Off. Appellants assert (brief, page 20) that because Off is not directed to a credit pre-verification system,

it would not have been obvious to have combined the teachings of Off with the teachings of Creekmore. It is further asserted (brief, page 21) that even if combined the combination would not result in the claimed subject matter. Appellants reiterate that Creekmore does not teach or disclose entering a unique identification code for a customer at a point-of-sale terminal, and assert (brief, page 21) "Creekmore does not teach or suggest entering into said terminal transaction data relating to the customers shopping transactions." It is argued (id.) that Off only teaches or suggests entering at a point-of-sale terminal transaction data relating to a current shopping transaction, and does not teach entering transaction data relating to the customer's prior shopping transactions. It is further argued (brief, page 23) that Off teaches away from the claimed invention because Off does not teach entering into a point-of-sale terminal a unique identification code for a customer, and therefore does not teach or suggest responding to an entry, during a current transaction, of a unique code for a customer, as recited in claim 15. It is additionally argued (brief, page 24) that Off is directed to detecting triggering products in a customer's current shopping transaction, and does not involve analyzing prior

shopping transactions or the identification of any particular customer.

From our review of Off, we find that Off is directed to a point-of-sale system for providing coupons or discounts to customers. We agree with the examiner that an artisan would have been motivated to combine the system of Off with the system of Creekmore, in order to provide a coupon generating system at the point-of-sale in Creekmore. However, from our review of Off, we agree with appellants that Off is not basing the generation of coupons or discounts on previous transactions, but rather on the current transaction. In addition, we find that Off does not disclose entering a unique customer identification number into a point-of-sale terminal. Accordingly, we find that Off does not make up for the basic deficiencies of Creekmore. The rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off is therefore reversed.

We turn next to the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off and further in view of Tai. The examiner's position (answer, page 6) is that Creekmore in view of Off does not disclose that the response is related to the individual

customer's transaction data in shopping visits prior to the current shopping visit. To make up for this deficiency in Creekmore and Off, the examiner turns to Tai for a teaching of this feature, to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping. Appellants assert (brief, page 26), neither Creekmore nor Off "teaches or suggests entering in the customer identification code from customer information presented at the point-of-sale in a retail transaction." Appellants further assert (brief, page 26) that Tai does not teach or suggest providing a response related to the individual customer's transaction data in shopping visits prior to the current shopping visit. It is argued (id.) that Tai has nothing to do with shopping visits prior to the current shopping visit since the system merely involves the mass mailing of coupons to prospective customers. The examiner responds (answer, pages 14 and 15) that Tai tracks and measures redemption of coupons by the heaviest product purchasing regular coupon using households, analyzing the redemption characteristics of various purchase incentive offers, so that consumer promotional behavior response patterns can be predicted (col. 3, lines 18-50). Appellants respond (supp. reply brief, page 4) that "Tai does not teach or suggest generating a

customer information response at the point-of-sale during the individual customer's transaction in the retail establishment upon detection of a unique identification code of the customer as set forth in claims 10, 11, and 14."

From our review of Tai, we agree with the examiner that Tai's disclosure of analyzing redemption characteristics of the heaviest product purchasers and regular coupon using households, suggests analyzing prior redemptions, which would involve the analysis of prior transactions. However, we agree with appellants (supp. reply brief, page 4) that Tai does not disclose generating the customer information response at the point of sale during the customer's transaction upon detection of a unique identification code of the customer, as set forth in independent claims 10 and 11, but rather generates customer response at an earlier time. In addition, we find that Tai does not disclose or suggest entering a unique customer identification code at the point-of-sale, and thus does not make up for the basic deficiencies of Creekmore and Off.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claims 10, 11 and 14. Accordingly, the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims ¹¹~~32~~ under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and further in view of Bigari. The examiner's position (answer, pages 6 and 7) is that the collective teachings of Creekmore, Off and Tai do not disclose the claimed dollar amount and time of purchase. To make up for this deficiency of the prior art, the examiner (answer, pages 6 and 7) turns to Bigari for a teaching of "manipulating the dollar amount and time of purchase" . . . "in order to more effectively target consumers while shopping for promotional offers designed by marketing agencies."

Appellants assert (brief, pages 29-33) that Bigari does not make up for the deficiencies of Creekmore, Off and Tai. It is argued (brief, page 29) that the examiner does not explain how Creekmore, Off and Tai are being applied to the claims. Appellants assert (brief, page 30) that Bigari does not disclose manipulating the dollar amount and time of purchase, but rather relates to a situation where the consumer must remove some of the items from his shopping basket because the dollar amount of the goods exceeds the maximum amount of the voucher.

The examiner responds, (answer, pages 16 and 17) that Creekmore, Off and Tai are relied upon in the same fashion as they were applied to claims 10, 11 and 14. The examiner adds

that Bigari sends response signal or updated transaction data based on charge card purchases. It is additionally asserted by the examiner (answer, page 20) that the claimed customer response signal is met by Bigari because a purchaser must satisfy stored transaction data by using a dollar amount based on the maximum charge permitted, and that this maximum charge relates to prior purchases because the charge is based on a response signal from the customer. It is further asserted (id.) by the examiner that the point of purchase accumulator meets the claimed "updating transaction data."

We note at the outset that independent claims 17 and 22 do not recite manipulating the dollar amount and time of purchase. Only independent claims 27 and 30 recite updating transaction data and dollar amount of purchases associated with a unique customer identification. We make reference to our findings, supra, with respect to Creekmore, as discussed with respect to claim 8. In addition, we find that Bigari is directed to implementing credit purchases at locations which require rapid throughput of transaction events (col. 3, lines 11-15). An object of the invention is to produce credit vouchers remote from the point of purchase station (cash register) (col. 3, lines 23-25 and 33-39). A charge card reader receives a customer credit

card and transmits customer identification to a host institution. In response to an approval signal, a print signal is produced resulting in the printing of a voucher for a maximum approved charge. The voucher is indexed with both transaction data and maximum approved charge data. The customer endorses the voucher, still at the location remote from the point of purchase station. The voucher thus becomes valid for the maximum amount of the proposed charge. The card holder only then approaches the point of purchase station, and places their order. The transaction is then totaled. The attendant at the point of purchase updates the voucher for an actual update amount, which is less than or equal to the maximum purchase amount approved by the host institution (col. 4, lines 1-28).

From this disclosure of Bigari, we find that Bigari's voucher apparatus is remote from the point of purchase, just as the check verification terminal of Creekmore is near but not at the point-of-sale terminal (see also col. 6, lines 14-17 of Bigari). However, although not brought to our attention by either the examiner or appellants, we find that Bigari additionally discloses (col. 9, lines 55-61) that figures 5 through 8 [sic,7] disclose an enhanced payment voucher processing apparatus and system wherein the point of purchase register is

integrated with the payment voucher processing apparatus 10
(underlining added). From the disclosure that the payment voucher processing apparatus may either be remote from the cash register or integrated with the cash register, we find that an artisan would have been motivated to integrate the check verification terminal of Creekmore integral with the point-of-sale terminal, permitting the check approval, based on prior transactions of a customer including the dollar amounts of checks previously presented, to be sent to the point-of-sale terminal. Accordingly, although we consider Off and Tai to be cumulative to the teachings of Creekmore and Bigari, we find that the teachings of Creekmore and Bigari suggest the limitations of claim 17.

We are not persuaded by appellants' assertion (brief, page 30) that the portion of Bigari relied upon by the examiner has nothing to do with prior purchase transactions, as this feature is taught by Creekmore, as discussed, supra.

Nor are we persuaded by appellants' assertion (brief, page 32 and supp. reply brief, page 4) that the prior art does not suggest the last limitation of claim 17 which recites "'wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer

identification," because in Creekmore, verification of the check will depend on data stored in the database which indicates the dollar amount of checks given in the past, and whether any money is due the merchant from checks that have been dishonored. We add that in Creekmore, the approval of the check will include a signal to the terminal in response to the request for approval.

Nor are we persuaded by appellants' assertion (supp. reply brief, page 4) that Bigari does not teach or suggest "'wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification," as this feature is disclosed by Creekmore, where the database stores the dollar amounts of checks presented at prior transactions by customers.

From all of the above, we find that the teachings of Creekmore and Bigari establish a prima facie case of obviousness of claim 17, which has not been successfully rebutted by appellants. The rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Creekmore in view of Off, Tai and Bigari is affirmed. As dependent claims 18-21 have not been separately argued, they fall with independent claim 17.

We turn next to independent claim 22. At the outset, we make reference to our findings, supra, with respect to the teachings and suggestions of Creekmore and Bigari. Appellants assert (brief, page 30) that claim 22 recites a computer implemented method which parallels claim 17, and relies on the same arguments presented for claim 17. In addition, appellants recite the last limitation of claim 22 (brief, page 32), and assert (brief, pages 32 and 33) that the subject matter referred to is not taught by Bigari. However, appellants provide no specific reasons in support of their assertion. We observe that the last limitation of claim 22, namely "wherein said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification," is met by the teachings of Creekmore and Bigari because the approval or non-approval of a customer's check depends on data stored in the database indicating the dollar amount of the check and whether any money is due to the merchant for the prior purchase. Accordingly, the rejection of independent claim 22 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 23-26 have not been separately argued, they fall with independent claim 22.

We turn next to the rejection of independent claim 27. At the outset, we make reference to our findings, supra, with respect to Creekmore and Bigari. Appellants assert (brief, page 32 and 33) that Bigari does not teach the last limitation of claim 27 which recites "'circuitry responsive to the entry of said unique customer identification and said transaction data at said terminal for updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database.'" However, appellants provide no specific arguments to support their position. We observe that the last limitation of independent claim 27 is met by the teachings of Creekmore and Bigari because in Creekmore, entry of a current transaction paid for by check, along with the dollar amount of the check, after entering the customer's unique (checking account) number, reads on updating transaction data (the fact that a check was cashed that day to pay for a transaction) and a dollar amount of purchases (the dollar amount of the check which is entered into the system). Accordingly, the rejection of independent claim 27 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 28 and 29 fall with claim 27, the rejection of claims 28 and 29 under 35 U.S.C. § 103(a) is affirmed.

We turn next to independent claim 30. Appellants assert (brief, pages 32 and 33) that the last limitation of claim 30, which recites "'updating transaction data and a dollar amount of purchases associated with said unique customer identification and said customer database in response to entry of said unique customer identification and said transaction data at said terminal" is not taught or suggested by Bigari. We are not persuaded by appellants' assertion because Creekmore discloses updating transaction data (entering into the database the use of a check by the customer that day to pay for a transaction and the dollar amount of purchases (entering into the system the dollar amount of the check cashed) associated with the unique customer identification (customer checking account number) in response to entry of the unique customer number (checking account number) and transaction data (the transaction of cashing a check to pay for a transaction) at the terminal. Accordingly, the rejection of claim 30 under 35 U.S.C. § 103(a) is affirmed. As dependent claims 31 and 32 have not been separately argued, they fall with independent claim 30. The rejection of claims 31 and 32 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claims 8, 9, 12 and 13 under the judicially-created doctrine of obvious-type double

patenting over claim 23 of U.S. Patent No. 5,305,196. The examiner's position (answer, page 7) is that "it would be [sic] obvious to add a terminal for a [sic] check transaction processing, database building and marketing method and system utilizing automatic check reading."

Appellants' position (brief, pages 37 and 38) is that the system defined by claim 23 does not include "means or a terminal for entering customer transaction data at the point-of-sale in the retail establishment; it does not have (1) a processor and a memory responsive to the apparatus for entering unique identification codes or (2) the terminal for entering customer transaction data for creating a database of a plurality of the retail establishment's customers' transaction data from prior shopping visits; nor does it have circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit." It is argued (brief, page 39) that the burden is on the examiner to show that the subject matter of the claims would have

been obvious from the subject matter of claim 23 of the 5,306,196 patent, and that the examiner has failed to carry that burden.

From our review of claim 23, we agree with the appellants that the examiner's assertions of what would have been an obvious addition to claim 23 are unsupported by any evidence in the record. The examiner's unsupported position is not a substitute for evidence. In the absence of any evidence establishing the obviousness of the limitations missing from claim 23, and the lack of any evidence of why an artisan would have considered the differences between claim 23 and claims 8, 9, 12 and 13, we find that the examiner has failed to establish a prima facie case of obviousness-type double patenting of claims 8, 9, 12 and 13. Accordingly, the rejection of claims 8, 9, 12 and 13 under the judicially created doctrine of obviousness-type double patenting is reversed.

We turn next to the rejection of claims 10, 11 and 14 under the judicially-created doctrine of obviousness-type double patenting as being obvious over claims 18 and 26 of U.S. Patent No. 5,201,010 in view of Tai. The examiner's position (answer, page 7) is that "[i]t would have been obvious to one skilled in the art to add the feature of a response being related to the individual customer's transaction data in shopping visits prior

to the current shopping visit in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.”

Appellants do not challenge the combinability of Tai with claims 18 and 26 of U.S. Patent No. 5,201,010, but rather assert (brief, pages 40 and 41) that Tai does not make up for the deficiencies of claims 18 and 26 of the '010 patent because Tai relates to prospective customers and has nothing to do with a customer's prior shopping history. It is argued (id. and supp. reply brief, page 6) that contrary to the examiner's assertions, Tai does not teach or suggest providing a response at the point of sale related to the individual customer's transaction data in shopping visits prior to the current shopping visit, upon detection of a unique identification code of the individual customer. At the outset, we make reference to our findings, supra, with respect to Tai. Although we agree with the examiner that Tai's revision of the mailing list in response to a customer's prior transaction (using a coupon that was mailed to the customer) we find that there is no teaching or suggestion in Tai of the response occurring at the point of sale. Accordingly, we find that the teachings of Tai in view of claims 18 and 26 of U.S. Patent No. 5,201,010 is insufficient to establish a prima

facie case of obviousness-type double patenting of claims 10, 11 and 14. Accordingly, the rejection of claims 10, 11 and 14 under the judicially created doctrine of obviousness-type double patenting is reversed.

We turn next to the rejection of claims 17-32 under the judicially created doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent No. 5,592,560. The examiner's position (answer, pages 7 and 8) is that it would have been obvious to have claimed broader subject matter than what is claimed in appellants' patent.

Appellants' position (brief, page 47) is that the examiner does not explain how the limitations of claims 17-32 would have been obvious over the subject matter of claims 1 and 3 of the '560 patent. It is argued (id.) that claim 17 includes a terminal for entering , during a transaction, the unique customer identification. In contrast, claim 1 of the '560 patent recites a terminal for entering selected indicia from identification presented by a customer in order to generate a unique identification code.

The examiner's response (answer, pages 24 and 25) is that both recitations perform the same function because a unique customer identification results from terminal data entry.

As a general principle, we agree with the examiner that the elimination of an element along with its corresponding function may be considered to have been obvious to an artisan. However, we do not find that situation to be before us as asserted by the examiner. Even though the result is that a unique customer number results, there is a big difference between a customer entering a unique customer number, and a system generating a unique customer code at a terminal. We agree with appellants that the terminal of claim 1 of the '560 patent performs a different function than the terminal of claim 17. As the examiner has failed to establish the obviousness of modifying the system of claims 1 and 3 of the '560 patent to arrive at the invention of claims 17-32, we find that the examiner has failed to establish a prima facie case of obviousness-type double patenting of claims 17-32. Accordingly, the rejection of claims 17-32 under the judicially created doctrine of obviousness-type double patenting is reversed.

NEW GROUND OF REJECTION UNDER 37 CFR §1.196(b).

We enter the following new ground of rejection under 37 CFR §1.196(b). Claim 33 is rejected under 35 U.S.C. § 102(b) as being anticipated by Creekmore. Creekmore discloses a computer implemented (general purpose digital computer functioning as

transaction processor 19) customer database (check cashing master file 20) comprising stored transaction data from prior point-of-sale transactions (check authorization may be determined by variable factors such as the customer's check cashing history, and the like (col. 8, lines 34-40)). In addition, Creekmore discloses that data regarding prior transactions are stored in association with an identification of the customer (applicant is assigned an account number and is issued a check cashing identification card having a magnetic stripe. The card may include the customer's checking account number, and a driver's licence number which is unique to the customer (col. 4, lines 30-47). Transaction processor 19 verifies whether the identification card is valid (col. 6, lines 10-40)). In addition, the transaction data includes the dollar amount of purchases and the time period (the customer supplies the dollar amount of the check being presented (col. 3, lines 9 and 10; col. 11, lines 11-14); the amount authorized counters 61 indicate the quantity of each type of check which can be authorized for the customer during each N-day period, and these quantities may be determined by variable factors such as the customer's check cashing history (col. 8, lines 34-40). A record of each check cashing approval transaction handled by processor 19 during a

particular day is maintained by the daily transaction log 71, which is updated by nightly update routine 72. Information from the nightly update routine is used to generate various reports and records relating to checks which were authorized and subsequently dishonored; amounts owed to subscribing merchants for approved checks which were dishonored; merchant billing for merchant use, and various statistical reports, as desired (col. 10, lines 29-56)). From all of the above, we find that Creekmore anticipates the invention set forth in claim 33.

OBSERVATIONS AND REMARKS

Because we are primarily a board of review, we have limited the rejection under 37 CFR § 1.196(b) to a single claim. We leave it to the examiner to determine whether any or all of the remaining claims are unpatentable over the prior art, in a manner consistent with our findings as to the teachings and suggestions of the prior art, as set forth, supra.

CONCLUSION

To summarize, the decision of the examiner to reject claims 33-39 under 35 U.S.C. § 101 is reversed.

The decision of the examiner to reject claims 8, 9, 12, 13 and 33-39 under 35 U.S.C. § 102 is reversed.

The decision of the examiner to reject claims 10, 11 and 14-16 under 35 U.S.C. § 103(a) is reversed.

The decision of the examiner to reject claims 17-32 under 35 U.S.C. § 103(a) is affirmed.

The decision of the examiner to reject claims 8-14 and 17-32 under the judicially-created doctrine of obviousness-type double patenting is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART
NEW GROUND OF REJECTION UNDER 37 CFR 1.196(b)

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Stuart S. Levy

STUART S. LEVY
Administrative Patent Judge

Howard B. McKinstry

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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